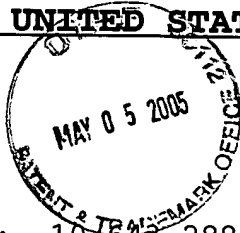


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:
F.L. Conte



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)
) Art Unit: 3643
)

Application No.: 10/643,288
Confirmation No: 4031

)
) Examiner: Rowan, K.
)

Filed: 08/20/2003
)

Title: Duplex Lash Insect Swatter

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
TRANSMITTAL OF APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR 41.31, Applicant hereby appeals to the Board of Patent Appeals and Interferences from the final decision of the examiner dated 12/17/2004, finally rejecting claims 1-20.

In accordance with 37 CFR 41.37, Applicant herewith encloses an Appeal Brief.

Enclosed is a check for the \$250.00 fee for filing a Brief in support of Appeal, in accordance with 37 CFR 41.20(b)(2).

Respectfully submitted,

Francis L. Conte

Date: 3 May 2005

6 Puritan Avenue
Swampscott, MA 01907
Tel: 781-592-9077
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Attachments:

CERTIFICATE OF MAILING (37 CFR 1.8a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to the: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

FRANCIS L. CONTE

(Name of person mailing paper) (Signature of person mailing paper)

3 May 2005

(Date)

BEST AVAILABLE COPY

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Art Unit: 3643

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Examiner: Rowan, K.

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Title: Duplex Lash Insect Swatter

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
APPEAL BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR 41.37, applicant hereby submits this Appeal Brief and requests that the decision of the examiner dated 12/17/2004 finally rejecting claims 1-20 be reversed and that these claims be allowed.

The Notice of Appeal was timely filed on 03/16/2005.

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CERTIFICATE OF MAILING (37 CFR 1.8a)

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FRANCIS L. CONTE
(Name of person mailing paper)

(Signature of person mailing paper)

3 May 2005
(Date)

REAL PARTY IN INTEREST

The real party in interest is Francis L. Conte.

RELATED APPEALS AND INTERFERENCES

The subject application discloses and claims improvements made to the insect swatter disclosed and claimed in application Ser. No. 08/331,851 which was filed on 10/31/1994; and recently issued as US Patent 6851218 on 02/08/2005.

In that parent case, two appeals were decided by the BPAI in Appeal No. 96-3971 and Appeal No. 2000-2033 reversing rejections made by the present examiner. And, in Appeal No. 02-1150 to the CAFC, a Judgment affirming certain rejections was entered on 06/05/2002.

STATUS OF CLAIMS

Claims 1-20 stand pending in the application.

No claims stand canceled.

No claims stand withdrawn.

No claims stand objected to.

No claims stand allowed.

Claims 1-20 stand finally rejected and are the subject of this Appeal Brief.

STATUS OF AMENDMENTS

There is no amendment filed subsequent to the final rejection; although a Response thereto was filed on 02/08/2005 and acknowledged in the Advisory Action dated 03/03/2005

BACKGROUND

A typical insect swatter, commonly referred to as a fly swatter, has a long handle with a proximal end configured for being gripped by a person, and a distal end at which is secured a generally rectangular, perforated wire or plastic mesh. In operation, the swatter is manually moved through the air for striking the insect with the mesh. However, the swatter must be moved very quickly in order to swat fast-reacting flies for example, or the fly will escape. The relatively large swatter mesh is apparently detectable by the insect either through its vision or by sensing the air being displaced as the mesh is moved.

If the swatter is moved quickly enough, the insect can be stricken which typically results in an offensive stain being created upon squashing of the insect.

An improved insect swatter is disclosed in U.S. patent application Serial No. 08/331,851, filed 10/31/1994, now US Patent 6851218. That insect swatter utilizes a long rubber band attached to the distal end of a long gun barrel or rod that can be stretched to a trigger latch at the opposite end of the rod at a handgrip.

Since the lash is elastic, it is able to store energy when stretched, and release that energy against the insect when it contracts during the whipping process. The elasticity of the lash also affects the effective striking range of the lash.

Continued development testing of the insect swatter has examined the effectiveness of the swatter, and uncovered problems therewith.

For example, short and stiff elastic lashes are not preferred since they have limited range and limited, if not impractical, ability to swat insects before detection. Long and resilient elastic lashes, on the other hand, have greater striking range, yet less available swatting energy, and are significantly weaker.

Furthermore, weak elastic lashes are more readily worn or damaged than strong lashes, and more quickly lose their swatting effectiveness. The typical rubber composition used in commercially available rubber bands is subject to environmental degradation which reduces the resiliency or stiffness of the bands, and the effectiveness thereof.

In view of these competing affects it is not practical to optimize elastic lash selection by merely choosing a band length and cross section for the specific size of the intended rod. And, custom made bands merely add to the cost of the swatter, and reduce the convenience thereof.

These problems have been solved in the improved insect swatter of the subject application.

SUMMARY OF CLAIMED SUBJECT MATTER

The claims on appeal include two independent claims 1 and 17.

Claim 1 recites an insect swatter 10 shown for example in figures 1 and 6. The swatter includes an elongate rod 12 having a proximal end 12a for being hand-held, and an opposite distal end 12b for being aimed at an insect as disclosed at page 3, ll. 13-23.

Cooperating with the rod is an elastic lash 34 including a pair of annular rubber bands 36,38 joined together at a knot 40 therebetween, and having a proximal end 18a fixedly joined to the rod distal end 12b, and an opposite distal end 18b sized for being elastically stretched from the rod distal end 12b to adjacent the rod proximal end 12a so that release of the lash distal end 18b spontaneously contracts the lash 34 for swatting the lash distal end 18b against the insect.

Figures 1, 2, and 4 illustrate the lash 18 in its original single-band form as patented in the parent application; and figures 5 and 6 illustrate the improved duplex lash 34 as recited in the present claims. The duplex lash 34 is introduced at page 9, line 29 through page 10, line 20; with additional reference to its substitution for the single-band lash 18 as further disclosed at page 3, line 24 through page 4, line 2, for example.

Independent claim 17 recites an insect swatter 10 including the elongate rod 12 having a slot 30 at a distal end 12b thereof; an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and joined together at a knot 40 therebetween; and the lash first loop 36 is retained in the slot 30.

Claim 17 shares common features with the claim 1 swatter as disclosed in the specification as indicated above, and specifically shown in figures 5 and 6.

The specific figure-eight (8) form of the lash 34 is disclosed at page 10, ll. 1-20.

Claims 1 & 5 specifically recite means for selectively releasing the latch 20, which means are disclosed in the specification at page 5, line 23 through page 6, line 17, and include the trigger 24 and the cooperating latch cam 20b joined to the latch 20.

The dependent claims are discussed below in the arguments section.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Ground (1) - whether claim 17 is unpatentable under 35 USC 112, first paragraph.

Ground (2) - whether claims 1-4 and 17 are unpatentable under 35 USC 103(a) over U.S. Patent 1,009,531-Kopp and In re Harza.

Ground (3) - whether claims 5-9 and 18-20 are unpatentable under 35 USC 103(a) over Kopp, U.S. Patent 2,642,057-Watkins, and In re Harza.

Ground (4) - whether claims 10-16 are unpatentable under 35 USC 103(a) over Kopp, Watkins, U.S. Patent 2,505,591-Stone, and In re Harza.

ARGUMENT

It is noted that the parent application required a literal 10-year odyssey to issue as a patent due in most part to the examiner's continued failure to afford due weight to Applicant's claimed invention, and an apparent bias against the invention.

The present examiner is the same examiner who handled the parent application, and this examiner has not yet allowed even one claim in the parent or this improvement application, with the parent being allowed to issue only by successful appeal to the BPAI, not once, but twice.

Patent Rule 104 is reproduced in part as follows:

(a) Examiner's action.

(1) On taking up an application for examination or a patent in a reexamination proceeding, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application or patent under reexamination with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) Completeness of examiner's action. The examiner's action will be complete as to all matters
....

(c) Rejection of claims.

(1) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the Applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

The parent application has undergone inordinate scrutiny by the Patent Office, and it is quite clear that Rule 104 has been violated in the re-opening of prosecution following the full reversal of the initial final rejection.

The examiner has used that re-opening of prosecution to avail himself of the differences of opinion between the first Board and the second Board in hearing that parent; and now, even with two Boards reversing the examiner's rejections, the examiner continues in his refusal to allow not even one claim, notwithstanding the specific problems confronting the Applicant and the remarkable solution embodied in the improvement claims.

The parent application has now issued in a U.S. patent, and the improvement claims are similarly entitled to patent issuance not only on their own merits, but for the merits of the common features found therein from the parent.

Yet, the examiner affords no weight to either those previous common features, nor to the improvement features, and yet again requires a third Board of Appeals to now decide de novo the patentability of the improvement claims.

Ground 1

Ground (1) - whether claim 17 is unpatentable under 35 USC 112, first paragraph.

Applicant traverses the rejection of claim 17 under 35 USC 112, first paragraph.

CLAIM 17

17. An insect swatter 10 comprising:
 an elongate rod 12 having a slot 30 at a distal end 12b thereof;
 an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and joined together at a knot 40 therebetween; and
 said lash first loop 36 is retained in said slot 30.

MPEP 2164.04 places the burden on the examiner to support an enablement rejection as follows:

In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. In *re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation why the scope of protection provided by a claim is not adequately enabled by the disclosure.) A specification disclosure which contains a teaching of the manner and process of making and using an invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented must be taken as being in compliance with the enablement of 35 U.S.C. 112, first paragraph, unless there is a reason to doubt the objective truth of the statements contained therein which must be relied on for enabling support.

The examiner has failed to explain how the specification fails to enable claim 17, and the examiner's examples disregard the clear teachings of the specification.

Claim 17 was modeled after claim 1 (which has not been rejected under Section 112), and recites in more particularity the figure eight lash 34 with first and second knot-less loops 18a,b at opposite ends of the two bands 36,38, with a knot 40 therebetween.

This species of the swatter recited in claim 17 is illustrated in Figures 5 and 6, and operates in the same manner shown in Figure 1, as expressly stated in para. 58.

This species of the swatter is also described at paras. 19,20,54-58,60,61,65 of the specification, for example.

Accordingly, the subject matter of this claim is clearly shown in the Figures, and clearly described in the specification, and well meets Section 112, first para.; and the examiner has not shown otherwise, nor explained any problem with the claim as written.

It is noted that claim 17 is an apparatus claim, and is not a method claim, and therefore no method-of-use needs reciting in this claim.

As for how the insect swatter is in fact used, the

specification well explains the method of use, and the examiner's question of use is not understood since the examiner has now been prosecuting the parent application for over a decade, and now prosecutes this improvement application, and it should well be apparent that the recited lash is used as a whip to whip insects, as the specification so explains in considerable detail.

Figure 6 clearly shows the lash 36 stretched on the gun in the same manner shown in figures 1-4, and release of the distal end of the lash unleashes the energy stored therein to propel the lash forward as shown in Figure 1 to strike the insect.

The examiner's mere statement that the "elastic lash is used to launch the elongate rod" is a facetious example, with no support in the specification or the figures.

The examiner's mere statement that the "rod is swung to kill insects with the elastic lash" is another facetious example, with no support in the specification or the figures.

And, the examiner's last example that "the elongate rod is used to launch the lash and if so how" better conforms with the specification, although the examiner's failure to afford due weight to that specification is perplexing.

If the description in the specification and the illustration in the drawings were deemed insufficient by the examiner, he was asked to explain why to clarify the issues for appeal, see MPEP 2164.01(c), but the examiner has failed to do so in the Advisory Action.

Accordingly, reversal of the rejection of claim 17 under 35 USC 112, first paragraph, is warranted and is requested.

Ground 2

Ground (2) - whether claims 1-4 and 17 are unpatentable under 35 USC 103(a) over Kopp and In re Harza.

Applicant traverses the rejection of claims 1-4 and 17 under 35 USC 103(a) over Kopp and In re Harza.

CLAIM 1

1. An insect swatter 10 comprising:
an elongate rod 12 having a proximal end 12a for being hand-held, and an opposite distal end 12b for being aimed at an insect; and
an elastic lash 34 including a pair of annular rubber bands 36,38 joined together at a knot 40 therebetween, and having a proximal end 18a fixedly joined to said rod distal end 12b, and an opposite distal end 18b sized for being elastically stretched from said rod distal end 12b to adjacent said rod proximal end 12a so that release of said lash distal end 18b spontaneously contracts said lash 34 for swatting said lash distal end 18b against said insect.

MPEP 706.02(j) provides the basic requirements which must be provided by the examiner in establishing prima facie obviousness under 35 U.S.C. 103. Four steps are required of the examiner including: (1) relevant teachings; (2) claim differences; (3) proposed modification of the reference(s) to arrive at the claimed subject matter; and (4) an explanation the proposed modification would have been obvious under Section 103.

The MPEP also requires a showing by the examiner of three basic criteria to establish a prima facie rejection including: first, evidence for the suggestion or modification for modifying or combining references; second, a reasonable expectation of success; and finally, the reference(s) must teach or suggest all the claim limitations, and cannot be based on Applicant's own disclosure.

Citing Ex Parte Clapp, the MPEP places the burden of proof on the examiner to provide evidence to support the conclusion of obviousness either from the references which must expressly or impliedly suggest the claimed invention, or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

It is the examiner who must meet this initial burden by applying specific evidence; and clearly the examiner has not met this burden with the incorrect interpretation of Kopp, and the attempt to use the Harza case without factual, logical, or legal nexus to the claims being rejected.

Furthermore, the examiner has failed to meet the stringent "legal motivation" requirements of MPEP ch. 2100, and has failed to consider the claims in the whole, or the applied reference(s) in the whole.

The examiner admits the fundamental shortcoming of Kopp in failing to show "two rubber bands," and fails to afford any weight to the disparate "one rubber band" of Kopp.

Claim 1 recites an elastic lash 34 including a pair of annular rubber bands 36,38 joined together at a knot 40 therebetween.

This is in stark contrast with the resilient band 5 of Kopp which is clearly disclosed as a **single-strand** band with knobs at both ends for retention. Clearly, Kopp fails to disclose or suggest even a single **annular** band as introduced in claim 1.

Why? Because the construction and operation of the toy gun in Kopp is quite different than that recited in Applicant's claims, and the examiner has not shown otherwise.

So that there can be no doubt, Applicant is attaching hereto an enlargement of figures 1 and 2 of Kopp which clearly show the **single-strand** band 5 of Kopp with special means (knob) 4 at one end, and special knob 6 at the opposite end which would require custom making.

The examiner then attempts to use the expedient of "given one rubber band, it would have been obvious to employ two for multiplied effect," citing In re Harza.

But, what does this mean? And, how is this relevant to the operation of the toy gun in Kopp, or the construction or operation of Applicant's different insect swatter?

How is it even possible to use two bands 5 in Kopp. Note, the one band disclosed has a knobs 4,6 at both ends, so

how would two bands 5 be configured or used?

What is the "multiplied effect" the examiner has in mind? Two stocks 2 side-by-side with two bands 5 in parallel? Two bands 5 side-by-side along the one stock 2? In these ways, would the two knobs 6 "multiply the effect" of striking the insect?

But, how is this relevant to claim 1 in which the bands are both annular, and joined together at a knot therebetween? What is the "multiplied effect" of that combination?

It is clear that the examiner has not evaluated any of Applicant's claims in the whole, or the applied reference in the whole, and uses the expedient of Harza in an unwarranted rejection of the claims.

What does Harza hold?

In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960), is cited in MPEP 2144.04 for the mere duplication of parts as a supporting rationale in modifying a reference based on legal precedent.

However, the use of legal precedent requires a careful analysis by the examiner of the relevant facts of the applied case compared with the claims at issue, and not simply the rote, per se use of the specific holding of the case without regard to context or facts.

Claim 1 in Harza recites a flexible water seal in a joint between a pair of poured masonry masses having a web with a plurality of ribs on opposite sides.

The Gardner reference disclosed a water stop between masses of concrete including a flexible strip having a plus (+) sign cross section which was considered to be a web with opposite ribs.

The rejection of claim 1 was affirmed by the CCPA who stated that:

The only distinction to be found is in the recitation in claim 1 of a plurality of ribs on each side of the web whereas Gardner shows only a single rib on each side of the web. It is well settled that the mere duplication of parts has no patentable significance

unless a new and unexpected result is produced, and we are of the opinion that such is not the case here.

However, claim 7 of Harza recites a water stop having a flexible web for the joint between the poured masonry material, with a plurality of parallel ribs integral therewith, and each rib being substantially as high as the spacing between adjacent ribs, and the ribs on opposite faces being laterally spaced in offset relation.

The CCPA did not affirm the Board's rejection of claim 7 over the three applied references Gardner, Roberts, and Schurman and stated that:

We do not agree with the board's affirmance of the rejection of claim 7. In this claim there exists an element which is neither disclosed in Gardner nor in Gardner in view of Roberts and Schurman, and two combinations of elements which are not suggested by any combination of the references. We refer to the feature of "each rib being substantially as high as the spacing between adjacent ribs." This is novel, and its utility, as expressed by the Applicant, is apparent. Further the combination of that element and the element defined by the recitation of "the ribs on said opposite faces being laterally spaced in offset relation" is patentably distinguishable from the references. Although Roberts shows the offset positioning claimed, we believe the offsetting in combination with the claimed dimensional relationship of the ribs produces new and unobvious results which are not suggested by any combination of the references. The other combination recited in this claim which we believe patentable consists of the feature of "a plurality of parallel ribs in spaced relation to one another on each of said faces" and the element of the ribs on opposite sides being spaced in offset relation. Even though we found in considering claim 1, that the plurality of ribs is not patentable per se and have stated that Roberts shows the offsetting of the ribs, we believe the two features taken together create a patentable combination.

Accordingly, although In re Harza confirms that the "mere duplication of parts has no patentable significance," that holding is qualified by "unless a new and unexpected result is produced," and that holding is clearly limited to "mere duplication," with any other change or difference

requiring due weight.

Indeed, in Harza, the minor additional features of rib height-to-spacing and offset configuration recited in claim 7 were found patentable by the CCPA in spite of the affirmance of the rejection of related claim 1.

The examiner does not compare the facts in Harza with those of the subject application and explain why, based upon this comparison, the legal conclusion in the present case should be the same as that in Harza. Instead, the examiner relies on Harza as establishing a per se rule that duplication of parts is obvious in all cases irrespective of the specific combination of elements, the specific cooperation thereof, and the specific utility.

The per se application by the examiner of In re Harza as found in MPEP 2144.04 is clearly not supported by that case or the MPEP, and the examiner has not cited any legal support for his bald conclusion of obviousness.

The examiner's mere duplication of the single-strand band 5 with end knobs lacks any explanation as to how that duplication would have been effected; lacks any explanation of the difference in single-strand band 5 versus annular band 34 of the claims; and fails ab initio to meet the factual and legal bases of Harza for mere duplication of parts.

Does Applicant's claim 1 merely recite two single strand bands 5 with end knobs like in Kopp? No, claim 1 recites much, much more, which the examiner has overlooked in the rush to reject the claims.

The Kopp's band must first be reconfigured from its single-strand form to annular form. Then the end knobs must be removed. Then two of those annular bands must be combined in some manner. And then, the end knobs must be returned.

But, the examiner has not explained any of such modification to meet claim 1, and has therefore failed to meet his burden.

Indeed, the examiner has conspicuously overlooked the present improvement invention and the specific problems being

solved over the parent patent application introduced in para. 4.

Note the specific problems presented in paras. 7-9 and 52 & 53.

Note the surprising new and unexpected results of the duplex lash as presented in paras. 55, 61-63, 65, 66, and 68-71.

Note, in particular the spring constant/stiffness advantage of two series springs as presented in para. 62 in which the stiffness is halved and the range is doubled.

In this regard, the examiner merely opines that "it would have been obvious to join the rubber bands [of Kopp] together to increase the range of the weapon." But, where is the evidence to support this bald contention? And, why would one skilled in the art want to do this when no such problem is found in Kopp?

How would the two single strand bands 5 of Kopp in fact be joined together as the examiner contends?

Why not place two, or more, single strand bands 5 on the stock 2 in parallel in the form of a multistrand whip?

The examiner's rejection is classic hindsight.

Harza does not support the examiner's bald contention, and, to the contrary, would appear to teach away from Applicant's claims which enjoy the special operation of in-series annular bands.

Note, the examiner must not only change the form of the single-strand band 5 of Kopp into not just a double strand, but an annular band as recited in claim 1; and then must also double that annular strand in the hindsight attempt to duplicate Applicant's claim 1 combination.

The changes required are quite profound, and the examiner has failed to meet the stringent requirements of the MPEP in supporting the rejection.

In response to the amendment filed 09/28/2004, the examiner merely repeated verbatim the previous rejections without further addressing the specific requirements of

Harza. The examiner's repeated use of Harza again fails to apply that case based on the facts thereof, and is therefore an impermissible use of the holdings thereof.

In para. 5 of the final office action the examiner uses examiner argument to merely contend why Harza is applicable, but examiner argument is never evidence.

The examiner has clearly failed to identify the facts of Harza, and apply the holdings thereof as required to invoke case law in support of the rejection.

The examiner is not permitted to re-define the facts or holdings of Harza as he sees fit to reject the present claims, and supplant the learned CCPA's opinion: this would present an impossible burden for Applicants before the USPTO.

The examiner merely opines that "Harza suggest[s] employing more than one of an item for multiplied effect." However, this is mere examiner argument, and the examiner has failed to identify any specific statement or holding in Harza to this effect.

Harza applies to the mere duplication of parts (MPEP 2144.04) under the fact pattern thereof. This holding does not support the examiner's mere argument, and the examiner has not shown otherwise.

The examiner again provides mere examiner argument that "This would encompass both having two rubber bands side by side and two rubber bands connected lengthwise...." The examiner then provides his mere opinion of advantages, with the bald conclusion that "This is the nexus between the art of record, the case law and the claims of the present invention."

However, the examiner has yet again failed to apply Harza under the facts thereof and under the specific holdings; which are very narrow to the mere duplication of parts.

The examiner was asked to re-read the Harza case, it is quite short, and notice that although claim 1 was rejected for "mere duplication of parts", claims 7 & 10 were not, nor

are they mentioned in MPEP 2144.04.

Indeed, by the mere addition of an apparently minor geometric variation in otherwise duplication of parts, the CCPA found claims 7 & 10 patentably distinguishable over the same references.

The present examiner is clearly using a subjective interpretation of the rote holding of Harza as found in the MPEP summary thereof, without regard to the specific facts of that case itself, and without regard to the express holdings; which holdings include finding patentably distinguishable features where duplication of parts is found, as long as some other difference is found in the claims.

The present examiner clearly fails to afford any weight to the claim language; now, and for the last decade in the parent application.

Applicant's insect swatter invention may be simple, but so was the water stop invention in Harza, which case is being used by the examiner not for what it fairly teaches, but as a mere vehicle in the MPEP reference thereto for the examiner to make unwarranted extensions thereof to deny Applicant the fair and objective evaluation of his claims over the relevant case law.

This examiner clearly would not have allowed claims 7 & 10 in the Harza case based on the simple differences therein; yet the CCPA did.

At best, Harza might suggest that two or more of the naked parts thereof might be duplicated; but which parts and why?

Where in Kopp is any analogy to the water stop facts of Harza?

Where in Kopp are any parts which could be used in the parallel configuration of Harza?

Perhaps the toy guns of Kopp might be merely duplicated and used side-by-side.

Perhaps, even two or more of the bands 5 might be duplicated and used side-by-side with corresponding

duplicated trigger mechanisms.

But, even such duplicated parts in Kopp does not appear supported by Harza, and the examiner has not shown otherwise.

There are just too many changes required in Kopp in addition to duplicating parts therein, and the examiner has not shown otherwise.

Any change in Kopp, other than the mere duplication of parts would appear patentably distinguishable based on a more careful review of Harza.

The examiner's mere contention that "two rubber bands side by side and two rubber bands connected lengthwise" have advantages is bald hindsight without any basis in Kopp or Harza.

In the first case, the examiner contends in para. 5 of the final office action that the "rubber bands would form a wider projectile...." But, where is this taught in Kopp and Harza?

What problem in Kopp is the examiner solving, and where is the examiner's analysis of the whole of Applicant's claims and the whole of the applied reference?

"Among legal standards for determining scope and content of the prior art, for example, are: a prior patent must be considered in its entirety, i.e., as a whole, including portions that would lead away from the invention in suit [citation omitted]." *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1953, 1597 (Fed. Cir. 1987), cert. denied, 41 U.S. 1052, 107 S.Ct. 2187 (1987).

"The well established rule of law is that each prior art reference must be evaluated as an entirety, and that all of the prior art must be evaluated as a whole... [I]nventions have been held to have been nonobvious where neither any reference, considered in its entirety, nor the prior art as a whole, suggested the combination claimed." *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 227 USPQ 337 (Fed. Cir. 1985), vacated & remanded, *Dennison Mfg. Co. v. Panduit Corp.*, 475 U.S. 809, 106 S.Ct. 1578, 229 USPQ 478 (1986), on remand; 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir. 1987), cert. denied, 41 U.S. 1052, 107 S.Ct. 2187 (1987).

The band 5 in Kopp clearly has a single strand with special knobs 4,6 at the opposite ends.

The lash 34 recited in claim 1 includes a pair of annular bands joined together at a knot 40 therebetween.

The single strand of Kopp clearly teaches away from the annular bands of claim 1 both as individual bands, and collectively as a pair of bands.

The examiner's bald contention of two side by side bands in Kopp fails to explain how they would be installed and operated in the toy gun.

The end of the stock 2 is configured to mount only a single knob 4, not two.

The other end of the stock 2 is configured to mount only a single knob 6 in the recess 8 of the fixed piece 7, and it is quite clear that it is not possible to mount two knobs 6,6 side by side in that one fixed piece 7 as the examiner's contention would require.

Alternatively, the examiner baldly opines that Harza encompasses two bands connected lengthwise, but where is this disclosed or suggested?

If the two bands were joined lengthwise in Kopp, how would this be done? Wouldn't such two bands be twice as long and therefore too long to function between the end of the stock 2 and the fixed piece 7?

Would the stock 2 have to be twice as long? Or, would those two bands have to be half as long for the same size stock?

It is the examiner who uses Harza for the mere duplication of parts in Kopp, but much, much more than mere duplication is required, yet the examiner must overlook this in the rush to reject.

In the second case the examiner merely opines that "the larger mass would be more effective for killing bigger insects and also, the two rubber bands connected in series would allow for different sized rubber bands to be used such as in the case where a user runs out of rubber bands of the

desired size."

Where is the evidence to support such bald statements?

Where is the evidence that larger mass would have any utility whatsoever?

The user in Kopp would not run out of bands if that user had a supply of such bands 5 to begin with, so why is the examiner fabricating a problem where none exists?

And, if that user ran out of the special bands 5 in Kopp how would it even be possible to substitute the typical annular rubber band for the special band 5? How would the typical annular band be mounted at the end to the stock 2 where the knob 4 is retained?

How would the annular band be retained in the recess 8 of the fixed piece 7 at the opposite end of the stock 2?

The examiner even argues that "Several smaller rubber bands could be employed with the same function as one larger one," yet where is the teaching of this?

The examiner's bald statements are conspicuous in their lack of evidentiary support, and the extension of the simple holding of Harza to the inapplicable facts of Kopp.

Many, many changes are required to modify Kopp as the examiner contends; yet Harza clearly holds that even a minor geometrical change in the apparatus was sufficient to find the claim patentably distinguishable.

The present examiner is interpreting Harza not for what it fairly, and narrowly, holds, but for what the examiner would like Harza to hold to uphold his insupportable rejection.

The examiner has been twice overturned on appeal to the Board in the parent case, and continues quite strenuously to reject the present improvement claims without regard to the novelty in the parent application as found twice by the Board of Appeals, and without regard to the novelty and advantages of the present claims.

On page 6 the examiner merely opines that "Applicant has not submitted any evidence that one rubber band functions any

different than two or more rubber bands to replace one longer one." What does this mean? And, how is this relevant to the claims, Kopp, and Harza?

The examiner has the burden to show by evidence that Kopp would have been modified by one skilled in the art, yet he has not met this burden.

The examiner has the burden to apply the holding of Harza objectively based on the facts thereof, and the examiner clearly has not.

In Kopp, a single band is used because only a single band can be installed on the stock as disclosed by Kopp. Why add multiple bands to Kopp? The examiner cannot use Applicant's claims as the guide. The examiner cannot turn the burden upside down, and require the Applicant to provide evidence of the negative.

In Harza, plural water stop features were found a mere duplication of parts in claim 1, but in claims 7 & 10 the plural water stop features were not found mere duplication of parts since these claims also recited a simple geometric variation.

In Applicant's claim 1, two annular bands are joined in series for specific benefit. In Kopp, a single strand band is used, and is not annular. Nevertheless, the examiner challenges Applicant as not submitting evidence regarding the number of bands?

To the contrary, paras. 62 et seq explain the substantial improvement of two bands in series as opposed to two bands in parallel. Spring rates or stiffness are fundamental features of mechanical design, and the series or parallel use thereof are clearly quite different, and the examiner has not afforded any weight to this difference.

Springs are fundamental elements of mechanical systems and have system counterparts in electrical circuits. And, in electrical circuits fundamental elements include resistors, for example, which also may be joined in series and parallel for different effect.

The issue is not the simplicity of a spring or a resistor, but how they are joined together in combination, and the function and advantages of the combination.

Just as resistors, capacitors, and transistors, may be simply duplicated and joined together on a printed circuit board in novel combinations in series or in parallel to effect a myriad of different functions and purposes, so too may springs and other mechanical parts be duplicated and joined together in myriad combinations for different functions and purposes.

Applicant's claims recite a special combination of bands in series for special purpose to solve special problems in an improvement application over the parent application, already found allowable by the Board of Appeals over the various rejections of the examiner. It is conspicuous that the examiner has not uncovered a single additional reference relevant to the new combinations now being claimed.

Instead the examiner is using the expedient of case law holdings found in brief extract in the MPEP, without apparent regard to the entirety of that case law, without regard to the facts of that case law, and without regard to the multiple holdings thereof which also apply to the non-obviousness of the claims when studied thoroughly and when applied objectively as intended; not applied subjectively in a vacuum as apparent from the examiner's bald remarks.

The examiner overlooks the specific features of the claims and the specific features of Kopp and the specific facts and holdings of Harza to deny Applicant claims to which he is entitled over the same art of record now being applied from the parent application in this decade long odyssey.

Para. 52 of Applicant's specification addresses problems uncovered during development testing of the insect swatter, including short or stiff bands.

Para. 53 addresses long or resilient problems.

Para. 61 discloses directional accuracy due to the knotted bands 36,38.

Paras. 62-65 disclose the series advantages of the spring constants in stretching, striking range, and energy.

Para. 66 discloses the advantage of the series bands not possible with single or parallel bands.

And, para. 69 explicitly discloses the results of development testing of the duplex lash and its "extraordinary effectiveness."

Yet the examiner has overlooked all of these teachings of the specification. The examiner baldly contends, without any regard to Applicant's specification that "Applicant has not submitted any evidence that one rubber band functions any different than two or more bands connected together."

To the contrary, Applicant has indeed submitted evidence in the specification that two annular elastic bands knotted together indeed function differently than one elastic band. This is the sine qua non of the duplex lash in the improvement application, the reason for its being; and this, the examiner casually overlooks without giving any weight whatsoever to the claimed features in the rush to reject, and re-reject the claims time and time again without deviation.

The long history of this insect swatter, the parent, and now this improvement provide amply evidence of the examiner's prejudgment against the patentability of the insect swatter, whatever its form, and whatever is recited in the claims.

Compounding the continued errors being made by the examiner, and the failure to consider either Applicant's claims in the whole or the applied reference(s) in the whole is the examiner's rote use of additional case law in para. 5 of the final office action.

The examiner's reference to McLaughlin is mere rote repetition from form paragraphs of the MPEP, and overlooks the fundamental errors in applying Kopp and Harza, and further compounds the errors of the rejection.

The examiner cites McLaughlin for "only knowledge which was within the level of ordinary skill..." yet has failed to support any of his contentions with any evidence of that

"knowledge," since clearly Kopp does not support any of the examiner's contentions regarding the use of "two rubber bands", nor does Harza.

The examiner's reference to Keller is again mere rote repetition from form paragraphs of the MPEP, and overlooks the fundamental errors in applying Kopp and Harza, and only compounds the errors of the rejection.

Indeed, the examiner's contention that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference," overlooks the fundamental rejection in para. 2 of the office action which uses a single reference, i.e. Kopp, not multiple references.

The examiner's fundamental basis for all the rejections is the use of Harza, which as indicated above clearly fails to support the examiner's use thereof, and to the contrary, the Harza case supports the patentable novelty of all the claims since the examiner has expressly failed to afford any weight to the clear differences recited in the claims which are much, much more than the mere duplication of parts.

The "combined teachings" as supported by Keller does not support the examiner's rejections. MPEP Chapter 2100 presents substantial guidance on what those "combined teachings" must entail, including the fundamental requirements of evidentiary support (not mere examiner argument) and legal motivation, clearly lacking in the examiner's rote rejections.

In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), emphasizes the evidentiary showing required by the USPTO in supporting an obviousness rejection for avoiding impermissible hindsight. The USPTO rejected as obvious claims for a trash bag colored orange in imitation of a pumpkin and decorative face for Halloween. The USPTO cited many references for creating Jack-O-Lantern bags, including conventional plastic lawn or trash bags. The Federal Circuit reversed the obviousness rejections as hindsight-based, and

summarized previous cases:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.... [In re Rouffet] "the Board must identify specifically . . . the reasons one of ordinary skill in the art would have been motivated to select the references and combine them." [In re Fritch] examiner can satisfy burden of obviousness in light of combination "only by showing some objective teaching [leading to the combination]." [In re Fine] evidence of teaching or suggestion "essential" to avoid hindsight. [Ashland Oil] district court's conclusion of obviousness was error when it "did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination." [Graham] "strict observance" of factual predicates to obviousness conclusion required. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability --- the essence of hindsight. [Interconnect Planning Corp.] "The invention must be viewed not with the blueprint drawn by the inventor, but in the state of the art that existed at the time."

We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.... although "the suggestion more often comes from the teachings of the pertinent references...." The range of sources available, however, does not diminish the *REQUIREMENT FOR ACTUAL EVIDENCE. THAT IS, THE SHOWING MUST BE CLEAR AND PARTICULAR....* Broad conclusory statements regarding the teaching of multiple references, standing alone are not "evidence...." In addition to demonstrating the propriety of an obviousness analysis, *PARTICULAR FACTUAL FINDINGS REGARDING THE SUGGESTION, TEACHING, OR MOTIVATION TO COMBINE* serve a number of important purposes, including: (1) clear explication of the position adopted by the Examiner and the Board; (2) identification of the factual disputes, if any, between the Applicant and the Board; and (3) facilitation of review on appeal. Here, however, the Board did not make particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references....

Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific - or even inferential - findings concerning the identification of the relevant art, the nature of the *PROBLEM* to be solved, or any other factual findings that might serve to support a proper obviousness analysis.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references *CAN* be combined to read on the claimed invention. For example, the Board... concludes that the *SUBSTITUTION* of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an *OBVIOUS DESIGN CHOICE*... Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate *HOW* the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. See Rouffet... noting Board's failure to explain, when analyzing the prior art, "what specific understanding or technical principle... would have suggested the combination." Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. [emphasis added]

The various contentions presented by the examiner in para. 5 of the final office action are clear examples of how the toy gun of Kopp could be modified or how it would have been combined with the teachings of Harza, yet those contentions lack any problem solving analysis, and lack any evidence in Kopp of any need or benefit for the modification, or that that modification would be in fact even possible given the special configuration of the knobbed-band 5 in Kopp and the special toy gun specifically configured therefor.

Accordingly, the examiner has failed to establish even a prima facie rejection of claim 1, which clearly recites elements and cooperation thereof neither disclosed nor suggested by Kopp, notwithstanding Harza, which would teach away from the examiner's proposed modifications.

CLAIM 2

2. A method of using the swatter 10 of claim 1 comprising:
stretching said lash 34 by pulling said distal end 18b thereof generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
aiming said rod distal end 12b at said insect; and
releasing said lash distal end 18b to spontaneously contract said lash 34 for swatting said lash distal end 18b against said insect.

The examiner's contention that Kopp "shows all the method steps of 2 and 4" is erroneous, and fails to afford due weight to the fundamental differences therebetween, and to the differences over Kopp.

The examiner has admitted that Kopp does not disclose "two rubber bands being joined together," and since claim 2 depends from claim 1 Kopp cannot show all the method steps as argued by the examiner.

Claim 2 recites a method of using the swatter recited in claim 1 as disclosed at paras. 23, 58, and 61, which includes stretching a pair of rubber bands on the rod to place the knot mediate the rod for the advantages described in the specification.

Kopp expressly teaches stretching the band 5 so that the end knob 6 is seated in recess 8, which is clearly not mediate the stock 2, but at the proximal end. This teaches away.

Kopp also teaches the use of a single-strand band 5, not an annular band, and it does not appear possible that an annular band could even function in the toy gun of Kopp. See *In re Gordon et al.*, 733 F.2d 900, 221 USPQ 1125, 1127 (Fed. Cir. 1984) on inoperable combinations which teach away from the examiner's proposed modification of Kopp.

The examiner applies Kopp for the mere duplication of parts, but has failed to explain how duplicated parts is the

same as duplication of the method recited in claim 2.

The examiner has proposed multiple alternate modifications of Kopp without explaining how any of those modifications would result in the method specifically recited in claim 2.

Since the insect swatter itself as recited in method claim 2 is much more than the mere duplication of parts of Kopp, the corresponding method of use thereof is clearly not disclosed or suggested by Kopp, and the examiner has not shown otherwise with any evidence of record.

CLAIM 3

3. A swatter 10 according to claim 1 further comprising:
a latch 20 pivotally joined adjacent to said rod proximal end 12a for releasably latching said lash distal end 18b; and
means for selectively releasing said latch 20 to release said lash distal end 18b for swatting said insect therewith.

Claim 3 introduces the latch 20, and is clearly written in the means-plus-function form of Section 112, para. 6 (see MPEP 6181), for the latch releasing means 24, 20b as correspondingly described in the specification at paras. 29, 30, and 32-34.

The examiner has failed to show any relevant latch or releasing means in Kopp, and has therefore failed to substantiate this rejection.

In claim 3 the latch 20 is pivotally joined by the pin 22a to the rod proximal end 12a as shown in figure 2 which latches the distal end of the lash in the form of the annular band.

In Kopp, the knob 6 is trapped in the recess 8 of the fixed piece 7, which piece 7 is clearly not pivotally joined to the stock 2, and the examiner has not shown otherwise. And it does not appear even possible that that recess 8 could latch an annular band lacking any knob 6 of the type

expressly disclosed by Kopp.

At para. 3 of the final office action, the examiner expressly admits that "Kopp ... does not show a latch pivotally joined to the handgrip." Where then is the examiner's evidence to reject claim 3 which expressly recites the pivoted latch?

Para. 32 of the specification introduces the latch releasing means in the form of the trigger 24 which is pivotally joined to the handgrip 14 by the pin 22b. The trigger 24 has a proximal end 24a which engages the latch cam 20b portion of the latch 20 for selectively releasing the latch 20 as described at paras. 33-36.

In Kopp, releasing means are disclosed at col. 1, ll. 46+, for the "end 6 of the band 5" which has no correspondence to the releasing means recited in claim 3 or the cooperating latch.

The releasing means in Kopp is the bent trigger 9 fixed to the stock 2 at the end 10, and having an opposite, upper end 13 offset below the recess 8.

In use the trigger 9 is moved upwardly to push the knob 6 out of the recess 8 as disclosed at col. 2, ll. 59+.

The examiner has clearly failed to show any correspondence between the fixed piece 7 and sliding trigger 9 of Kopp with the pivoted latch 20 and releasing means 24,20b therefore.

Irrespective of the breadth of interpretation of the releasing means 24,20b as recited in claim 3 and as disclosed in the specification, the examiner has failed to identify any corresponding structure in Kopp, and has failed to show how any duplication of parts therein in accordance with Harza could even colorably support the rejection of this claim.

The examiner's rote rejection of claim 3 is additional evidence of failure to meet the stringent evidentiary and legal requirements of the MPEP, and failure to consider the individual claims in the whole, and the applied reference in the whole.

CLAIM 4

4. A method of using the swatter 10 of claim 3 comprising:
stretching said lash 34 by pulling said distal end 18b thereof generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
latching said lash distal end 18b to said latch 20;
aiming said rod distal end 12b at said insect; and
releasing said latch 20 for spontaneously contracting said lash 34 for swatting said insect with said distal end 18b thereof.

Claim 4 recites the method of using the swatter of claim 3 as disclosed at paras. 31-36 and 58.

The duplex band lash 34 is pulled to latch the distal end 18b thereof to the pivoted latch 20, which is in stark contract with trapping the knob 6 in Kopp in the recess 8 of the fixed piece 7, which does not pivot.

Claim 4 also places the knot 40 mediate the rod in a configuration that does not appear possible in Kopp, and the examiner has not shown otherwise in his bald contention of "all the method steps."

Claim 4 recites releasing the latch 20 for spontaneously contracting the lash, but the trigger 9 in Kopp clearly does not and cannot release the fixed piece 7.

The examiner's use of Harza for duplicating parts would appear to merely duplicate the clear differences between the duplicated toy gun of Kopp and the method recited in claim 4.

The examiner's bald rejection of claim 4 is therefore yet further evidence of the failure to consider the claims and the reference in the whole.

CLAIM 17

17. An insect swatter 10 comprising:
an elongate rod 12 having a slot 30 at a distal end 12b thereof;
an elastic lash 34 configured in a figure eight with first and second knot-less loops 36,38 at opposite ends, and

joined together at a knot 40 therebetween; and
said lash first loop 36 is retained in said slot 30.

Independent claim 17 was added by amendment, and the examiner has failed to explain any rejection thereof as required by the MPEP, but has only addressed this claim in the Section 112 rejection traversed above.

As indicated above, claim 17 was modeled after claim 1 and recites the rod 12 and cooperating elastic lash 34.

The lash 34 has a figure-eight configuration as shown in figures 5 and 6 due to the combination of two annular bands 36,38 at the joining knot 40 therebetween, with those two bands forming knot-less first and second loops at opposite ends. The first loop 36 is retained in the slot 30 of the rod 12.

This embodiment is disclosed at paras. 19, 20, 21, and 57, for example, as indicated above.

For the same reasons presented above traversing the rejection of claim 1, it is not seen how the examiner has established even a prima facie rejection of claim 17.

In particular, even if the band 5 of Kopp were duplicated in series in accordance with the examiner's use of Harza, those two bands 5 would still be single-strands lacking any annular feature, lacking any figure-eight configuration, and lacking any end loops for cooperation with the rod as recited in claim 17.

The examiner's failure to even provide any comments pertinent to the rejection of added claim 17 under Section 103(a) is further evidence of the failure to consider that claim in the whole, and the applied reference in the whole.

Claim 17 clearly recites a combination of features neither disclosed nor suggested by Kopp and Harza, and the examiner has not shown otherwise in the continued rush to reject all claims without due consideration thereof.

Accordingly, reversal of the rejection of claims 1-4 and 17 under Section 103(a) over Kopp and Harza is warranted and

is requested.

Ground 3

Ground (3) - whether claims 5-9 and 18-20 are unpatentable under 35 USC 103(a) over Kopp, Watkins, and In re Harza.

Applicant traverses the rejection of claims 5-9 and 18-20 under Section 103(a) over Kopp, Watkins, and In re Harza.

CLAIM 5

5. A swatter 10 according to claim 3 further comprising:
a gun handgrip 14 fixedly joined to said rod proximal end 12a;
said latch 20 being pivotally joined to said handgrip 14; and
wherein said latch 20 releasing means includes a trigger 24 operatively joined to said latch 20 for releasing said latch 20 upon pulling said trigger 24.

The examiner compounds the errors of rejection, firstly by incorporating the fundamental errors associated with the rejection of claims 1-4, and secondly failing to afford due weight to express claim language, not only in these claims, but now also in claims 5-9 dependent therefrom.

Furthermore, the examiner's hindsight reconstruction is transparent: selectively choosing features of the disparate references without regard to the express teachings thereof or the fundamental differences found in these references.

Claim 5 recites the handgrip 14, latch 20 pivotally joined thereto, and trigger 24 joined to the latch for release thereof as disclosed at paras. 20, 30, and 32, for example. The latch cooperates with the duplex band lash 34 for latching one of the loops thereof, with the knot 40 between the opposite ends.

In Kopp, a single-strand band 5 is disclosed, and cooperates in a specific manner using the end-knob 6 in the

recess 8.

In Watkins, a quite different rubber band 14 is disclosed, and cooperates with a leather loop 16 secured to the end thereof by string or wire 37, which in turn is retained on pin 18. The purpose of the leather loop 16 is to hurl the projectile 20. And, the rubber band 14 must, therefore, be large and strong, as clearly shown in the figures.

The examiner must necessarily **disregard** these fundamental teachings of the two disparate references in his rush to reject the present claims, using Watkins quite apparently for the handle 12 disclosed therein in attempting to match the gun handgrip recited in claim 5, without regard to the basic teachings of Watkins, which clearly teach away from any combination with Kopp, not the converse.

The examiner even erroneously contends that Watkins shows "a latch 18 pivotally joined to the handgrip," when there appears to be no evidentiary support for this. See col. 3, ll. 10 & 53 which expressly teaches that the pin 18 is withdrawn downwardly or vertically, and how can such translation movement possibly be interpreted as being pivotal?

Note further, that Kopp discloses a single-strand band 5; and Watkins discloses a single rubber band 14. So, how is it even possible to use two bands 5 or two bands 14 in either structures of Kopp and Watkins?

The band 5 of Kopp is thin, and knobbed.

The band 14 of Watkins is fat, and supports the leather loop 16 tied thereto.

So, where is any evidence or teaching in the two references being applied that two bands could in fact be used for any practical benefit; and how should those two bands be used without destroying the original operation of these disparate references.

Note, quite significantly, that both references Kopp and Watkins disclose different forms of single bands 5,14; and

the examiner must, yet again, apply Harza for the mere duplication of parts. Which parts?

The band 5 of Kopp or the band 14 of Watkins?

The band 5 of Kopp would clearly not function in the apparatus of Watkins; and the band 14 of Watkins would clearly not function in the apparatus of Kopp, so what combination? What modification? What duplication?

The examiner attempts to use the disparate references as mere parts bins, and to use Harza for duplicate parts in a bin. But, this provides no basis to modify Kopp or Watkins in any way relevant to Applicant's claims. The hindsight reconstruction being used by the examiner is palpable, and clearly evident in the verbatim repeat of the rejections in the two office actions, and by the examiner's boot-strapping response in para. 5 of the final office action.

The errors of the examiner's rejections merely compound as the examiner advances in his drive to deny Applicant any claims to which he is entitled by Statute, and a repeat of the odyssey in the parent application.

It is noted that the same examiner prosecuted the parent application, which has finally ended in the issuance of a patent after ten years. And, the same examiner did not allow one claim in that parent application; and now continues to reject each and every claim of this application, without regard to the new problems uncovered, or the new solutions being presented in this application.

This Applicant implored the examiner to reconsider this application on its own, new merits, and try to more objectively evaluate the new claims, and the remarks in traverse of the new rejections, and possibly find claims allowable? But, this request has been ignored.

Ten years, two appeals to the Board of Patent Appeals and Interference, and the appeal to the Federal Circuit, are much too much effort to repeat in the present application.

For some reason the examiner has been unable to allow any claims in both of these applications, and it took two

appeals to find the allowable claims. Could we not now short circuit that appeal process, and finally afford some weight to the patentability of the present claims, and their considerable improvement over the parent application, as well as over the same references now being (re)applied?

It is noted that all of the references of record were submitted by the Applicant, and the examiner has failed to uncover any new references in the present application.

The art of record has been well explored now by two Boards of Appeal and the Federal Circuit, and that art includes disparate references notwithstanding the apparent simple nature of the elastic band operations thereof.

The examiner is duty bound under the MPEP to evaluate claims in their whole, including the specific problems being solved and the new solutions therefor.

The examiner is also duty bound to evaluate the references in the whole, and the problems therein to determine what combination thereof would have been obvious to one skilled in the art under the guidelines of MPEP ch. 2100.

If this were done objectively in accordance with the applicable provisions of the MPEP, Applicant is certain that the examiner should have found the allowability of the claims of record, especially when considering that two Boards of Appeal have found allowable the even simpler claims in the parent application, which the present examiner refused to allow.

As indicated above, the differences between claim 5 and the applied references are substantial and fundamental, and the examiner has failed to afford due weight thereto, and instead has looked at apparent similarities only.

The examiner's mere contention to combine the two references lacks specificity of what that combination should entail; how any such combination would even be possible; and the proffered "purpose of providing easier cocking" is a classic hindsight conclusion, neither meeting the legal motivation requirements of the MPEP nor based on any

identified evidence.

Easier cocking? How?

Kopp requires a recess 8 to retain the knob 6.

Watkins requires a pin 18 to retain the leather loop 16.

The differences could not be greater; so where is any logical basis or evidence to support the bald contention of "easier cocking?" Where is the teaching of any problem requiring any "easier cocking?"

The hindsight in this contention by the examiner is quite conspicuous, and divorced of logic under the facts of the two references being applied in some unexplained combination of disparate elements.

Claim 5 clearly recites patentable subject matter as identified above having no counterpart in the applied references.

CLAIM 6

6. A method of using the swatter 10 of claim 5 comprising:
stretching said lash 34 by pulling said distal end 18b thereof generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
latching said lash distal end 18b to said latch 20;
gripping said handgrip 14 to aim said rod distal end 12b at said insect; and
pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

The examiner's contentions regarding method claims 6 and 8 merely paraphrase Applicant's claims without regard to the fundamental differences of structure and method; and without regard to the different product claims 5 and 7 from which they depend.

Claim 6 recites the method of using the swatter of claim 5 by latching the distal end 18b of the duplex lash 34 on the latch 20, gripping the handgrip to aim the rod, and pulling the trigger to release the latch and contract the lash 34.

As indicated above, neither Kopp nor Watkins disclose or

suggest duplex lashes joined together at a knot therebetween.

The double band lash recited in Applicant's claims is fundamentally different than the single bands disclosed in Kopp and Watkins; and the latching method is corresponding quite different; and the method of use is therefore quite different, notwithstanding the examiner's unsupported contention to the contrary.

The knob 6 in Kopp is seated in the recess of the fixed piece 7, which clearly is not pivotable; nor does the trigger 9 operate to pivot that fixed piece 7.

The pin 18 in Watkins is clearly not pivotable, nor does the trigger or finger hold 28 operate to pivot that pin 18.

"Easier cocking" the examiner opines for a combination of Kopp and Watkins neither explained by the examiner, nor possible, and certainly not suggested by these two references in any manner required by the MPEP including the legal motivation requirements therefor.

"Easier cocking" is rote, hindsight fabrication by the examiner in its most conspicuous form without regard to the very references being applied.

How could the cocking of the simple trigger 9 of Kopp be any "easier" by adding thereto the substantially more complex finger hold 28 of Watkins? The examiner has not explained this since he cannot in the rush to reject the claims without regard to merit.

Claim 6 clearly recites a patentable combination of features in the use of the product recited in claim 5, and the examiner has not shown otherwise.

CLAIM 7

7. A swatter 10 according to claim 5 wherein:
said rod distal end 12b includes a keyhole slot 30; and
a first one 36 of said rubber bands 36,38 includes said lash proximal end 18a forming a first loop 36 disposed through said keyhole slot 30 for fixedly joining said lash 34 to said rod 12, and a second one 38 of said rubber bands 36,38 includes said lash distal end 18b forming a second loop

38 positionable around said latch 20 for being retained thereby.

The examiner has failed to afford due weight to claim 7, and merely contends that "it would have been obvious to employ two rubber bands for the same reasons stated above." What were those reasons?

Harza? But, the examiner has failed to establish any basis to apply the facts or holdings of Harza to claim 7; and has also failed to show how two bands would be a mere duplication of parts. And, the examiner has failed to address the combination of features recited in claim 7, and how those two bands cooperate.

How would it be even possible to employ two bands 5 in Kopp or two bands 14 in Watkins?

The fundamental failures of Kopp and Harza have been addressed above.

In Watkins, a single band 14 is attached by the string/wire 37 to the leather loop 16. Would one skilled in the art replace either the band 14 or the loop 16, or both, with another band 14 or loop 16, or both, in accordance with the examiner's proposed use of Harza?

Where is the duplication of parts in Watkins, and what to do with Kopp?

Should Watkins now use two bands 14 with a single leather loop 16? How? In parallel? In series? In what other configuration?

Should Watkins now use two leather loops 16? Where is the duplication of parts? And, how would those duplicate parts be combined with the knob 6 and recess 8 of Kopp, or with the pin 18 of Watkins?

The examiner's mere contentions are conspicuous for their simplicity, and lack of due deference or weight to the express teachings of the applied references. The hindsight reconstruction is equally transparent, because that hindsight reconstruction lacks specificity, and is not based on

evidence, nor problem-solving in either of the two references, and lacks legal motivation mandated by the MPEP.

Instead, the examiner addresses solely the "keyhole slot 34" of Watkins, without regard to the knob 4 in Kopp with its different method of attachment; and without regard to the combination of features recited in claim 7 including the first loop 36 in the keyhole slot 30 and the second loop positioned around the latch 20.

In neither Kopp nor Watkins is any band shown or suggested which has a loop that is held by a pivotable latch 20 released by a trigger.

Claim 6 clearly recites patentable subject matter, overlooked by the examiner in the attempted hindsight reconstruction thereof from disparate references.

CLAIM 8

8. A method of using the swatter 10 of claim 7 comprising:
stretching said lash 34 by pulling said lash second loop 38 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;
latching said lash second loop 38 around said latch 20;
gripping said handgrip 14 to aim said rod distal end 12b at said insect; and
pulling said trigger 24 to release said latch 20 to spontaneously contract said lash 34 for swatting said insect.

Method claim 8 has been grouped by the examiner with method claim 6, which depend from different claims, and are therefore themselves quite different, which differences have not been afforded any weight by the examiner in the continued rush to reject (all) the claims.

Claim 8 includes two elastic bands 36,38 in which the second loop 18b is latched around the latch, with the knot 40 being placed mediate the rod. Claim 8 also recites the keyhole slot 30 in which is retained the first loop 18a.

The examiner merely opines that Watkins shows a keyhole slot 34, etc., but the examiner has failed to afford any

weight to the different features recited in method claim 8, and the different operation thereof. General similarities may exist, but claims are entitled to patentable weight, not for the similarities, but for the differences.

Although Watkins shows a keyhole slot, Kopp does not.

Kopp discloses the knob 6 in the recess 8, and Watkins does not. Instead, Watkins discloses the leather loop 16 around the pin 18.

So, where is the evidence to mix and match the disparate features of these two references in any manner implied, but not explained, by the examiner?

The examiner's bald contentions regarding these claims are not supported by the references, and fail to afford any weight, let alone, due weight to the claim language.

And, and quite significantly on the substantial benefits of using the two recited bands joined together by the intermediate knot 40, the examiner rests the entirety of the rejections on the Harza case dealing with the mere duplication of parts; yet the examiner has failed to, and cannot, show any nexus between the facts of Harza and the facts of Kopp, Watkins, or Applicant's claims.

The examiner has also failed in this regard to show how it would even be possible to merely duplicate any parts of Kopp and Watkins. Duplicate the single strand band 5 of Kopp? How? Why? And, what about the end knobs of that band?

Duplicate the rubber band 14 of Watkins? How? Why? And, what about the leather loop 16? Duplicate it?

As for the method features of Kopp and Watkins proffered by the examiner in para. 3, those features fail to cooperate with a pivotable latch 20 or a trigger 24 in the manner recited in method claim 8.

Accordingly, method claim 8 recites patentable features neither disclosed nor suggested by Kopp, Watkins, and Harza, and the examiner has not shown otherwise.

CLAIM 9

9. A swatter 10 according to claim 7 wherein:
said latch 20 extends upwardly from said handgrip 14;
said keyhole slot 30 is open downwardly in a direction
opposite to said upward extension of said latch 20; and
said lash 34 is inclined upwardly from said keyhole slot
30 to said latch 20 when latched thereto, and said knot 40 is
positioned atop said rod 12.

Claim 9 recites the upward extension of the latch 20;
the downward direction of the slot 30; and the position of
the knot 40 atop the rod.

There is no slot in Kopp, see knob 4.

The slot 34 in Watkins extends upwardly, not downwardly
as the examiner contends, and the examiner has failed to
afford any weight to what a keyhole slot entails in its
fundament nature, i.e. a keyhole and a slot joined thereto.

How should the disparate teachings of Kopp and Watkins
be combined? The examiner has not explained this in his rush
to reject.

The knob 6 in Kopp is located in the recess 8, not
mediate the rod. The string/wire 37 in Watkins is located at
the end of the rubber band 14, and the loop 16 is not a
rubber band looped around the pin 18.

And, the fixed piece 7 in Kopp is not a pivoted member,
nor is the pin 18 in Watkins.

The differences between claim 8 and the applied
references are many, and claim 8 clearly recites patentable
subject matter, without the examiner showing otherwise.

CLAIM 18

18. A swatter 10 according to claim 17 further comprising:
a handgrip 14 fixedly joined to a proximal end 12a of
said rod 12 opposite from said distal end 12b thereof;
a latch 20 pivotally joined to said handgrip 14 adjacent
to said rod proximal end 12a for releasably latching said
lash second loop 38; and
a trigger 24 operatively joined to said latch 20 for

releasing said latch 20 upon pulling said trigger 24.

Claims 18-20 were added in the first amendment, and the examiner has failed to address these claims one by one, and has therefore failed to establish even a prima facie showing.

Claim 18 depends from new claim 17 and recites the swatter 10 including the figure eight lash 34 with knot-less loops 36,38 at opposite ends.

In Kopp, the band 5 has a knob 6 at its distal end, and is a single strand.

In Watkins, the band 14 is annular, with the leather pouch 16 at the string 37 end.

The examiner's contentions in para. 3 appear to be verbatim with those presented in the earlier rejection in para. 3, and lack any analysis of the novel features recited in claims 18-20.

The features listed in claim 18 above are clearly not disclosed or suggested by Kopp and Watkins, and the examiner has not shown otherwise; nor has the examiner explained any modifications of these disparate references for any reason; nor has the examiner presented any legal motivation for making such modifications.

Claim 18 recites the handgrip 14, pivotable latch 20 and cooperating trigger 24; yet as explained above the fixed piece 7 in Kopp is not pivotable nor is the pin 18 of Watkins, nor do those elements 7/18 cooperate with a trigger in the manner recited in claim 18.

The examiner simply opines that it would have been obvious to combine these disparate references for "providing easier cocking."

Yet, how much easier could the cocking of the trigger 9 in Kopp be?

As explained above, the examiner has failed to provide any modification of Kopp in which the trigger hold 28 mechanism of Watkins could be used to work in any manner, let alone the manner recited in claim 18; and any such

modification of the trigger 9 in Kopp would clearly render it inoperable for pushing the knob 6 out of the recess 8.

Claim 18 clearly recites patentable subject matter yet again overlooked by the examiner in the rush to reject the claims without regard to the specific combinations thereof.

CLAIM 19

19. A swatter 10 according to claim 18 wherein said lash 34 includes a pair of annular rubber bands 36,38 joined together in series at said knot 40, and having a collective spring 26 rate equal to the reciprocal of the sum of the reciprocals of the spring 26 rates of each of said bands 36,38.

Claim 19 recites the two annular band species, joined in series with a collective spring rate equal to the reciprocal of the sum of reciprocals of the individual spring rates as disclosed at paras. 54, 62, and 63.

This combination provides unexpected benefits in increasing stretch capability with reduced stiffness providing enhanced swatting range and efficacy.

Since the applied references use single bands, with an end knob in Kopp and an end leather loop in Watkins, there is no disclosure or suggestion in these disparate references to utilize series springs for any advantage.

The examiner has not addressed this claim in accordance with the MPEP provisions, but simply opines in para. 5 of the office that "two rubber bands side by side and ... connected lengthwise" would be encompassed by the Harza, without any identification in Harza to support this.

In para. 4, a different rejection, the examiner buries claim 19, along with claim 16, and merely argues that "no stated problem is solved." Yet, the specification is replete with stated problems, expressly disclosed in the Background at paras. 6+; and corresponding solutions at paras. 61+.

And, in para. 4 of that different rejection, the examiner fails to address the substance of claim 19, let

alone that claim in the whole.

Where in Harza is any holding by the CCPA that series arrangements of elements is encompassed by parallel arrangement of elements?

Note, in particular, that claim 7 in Harza expressly recites a "plurality of parallel ribs," yet nowhere in Harza does the CCPA hold that those ribs would encompass series-ribs as the present examiner contends.

Indeed, series-ribs in Harza appear impossible, and would destroy the function of the water seal/stop for sealing the joint. Further illogical in the present examiner's attempt to encompass series-ribs from parallel ribs would be the evisceration of the main holding in Harza since if their were not a plurality of parallel ribs then there would be no mere duplication of parts for which the Harza case is being applied?!

In para. 5 the examiner merely opines that "Applicant has not submitted any evidence that one rubber band functions any different than two or more rubber bands connected together."

As indicated above, the examiner has clearly overlooked the express disclosure and evidence of testing presented in the specification of the remarkable performance of two bands joined in series, which would be quite different than two bands joined in parallel.

Also in para. 5 of the final office action the examiner substitutes his judgment that two rubber bands joined either side by side or lengthwise would have "more mass" or "larger mass" for his proposed benefits, yet where is the examiner's evidence that "more mass" would have any additional efficacy in swatting insects.

And, why has the examiner overlooked the fundamental knowledge of the differences between in-series elements and in-parallel elements.

The electrical analogy was presented above with electrical resistors joined in series having well known

different performance compared with electrical resistors joined in parallel, and the effective resistance thereof is also notoriously well known by different equations.

Similarly, springs in mechanical mechanisms have different spring rates in the different combinations of in-series and in-parallel. The different spring rates affect different performance in the combination, with "more mass" thereof being irrelevant; and in the case of the present examiner, the mere proffer of "more mass" is evidence of the failure to afford any weight to those recited bands in-series.

Para. 62 of the specification discloses the series combination of bands 36,38 and the resulting spring constant or stiffness, which is quite different than springs in parallel in which the spring rates are additive, or stiffer.

Paras. 63-70 present additional advantages of the series bands, which would appear quite remarkable and unexpected, and the examiner has not shown otherwise by explanation or the application of a relevant reference.

It is again noted that the examiner has not uncovered even one additional reference in support of his bald contentions, instead attempting to rely on examiner argument alone, and the modicum of evidence in the attempt to support rejections.

Claim 19 is particularly patentable over the applied references in view of the specificity of the series spring rate, and the attendant advantages thereof as disclosed in the specification, and which advantages are due due weight when evaluating the claims in the whole.

CLAIM 20

20. A swatter 10 according to claim 19 wherein said pair of rubber bands 36,38 are identical in size, cross section, and material composition, and have equal lengths to position said knot 40 midway between said first and second loops.

Claim 20 recites the bands 36,38 being identical in size, cross section, and material composition, with equal length to place the knot 40 midway therebetween as disclosed at para 56, and has no counterpart in Kopp and Watkins.

The examiner has overlooked this claim, and its specific features in the rush to reject the claims based on the mere duplication of parts holding of Harza.

Yet again in para. 4, a different rejection, the examiner also buries claim 20, along with claim 16, and merely argues that "no stated problem is solved." Yet, the specification is replete with stated problems, expressly disclosed in the Background at paras. 6+; and corresponding solutions at paras. 61+.

And, in para. 4 of that different rejection, the examiner fails to address the substance of claim 20, let alone that claim in the whole.

As indicated above, how would the different bands of Kopp and Watkins be combined in the first instance?

Which features from which bands would remain in the final band as used in Kopp?

And, where is the teaching of the size or configuration of the combined bands of these disparate references configured for different purposes?

The examiner's rejections fail to address these critical issues, and fail to meet the stringent requirements of the MPEP.

Of what value would two bands 5 have in Kopp? How would they be joined? "More mass" the examiner simply opines, but why would you need two bands 5 to provide more mass?

Would not those two bands 5 have to be half-size each to fit on the same stock 2? And, if so, where then is the "more mass" contemplated by the examiner. Would not two bands 5 of half length have the same mass as one band of full length?

As for Watkins, why add to the complexity of the already complex band 5 with leather loop 16. The examiner opines "more mass," yet as indicated above would not two bands 14

from Watkins require half length to fit the same stock 2 of Kopp, and then would not those two half-length bands 14 have the same mass as their full length counterpart?

The examiner is being trapped in his own distorted logic. The classic hindsight being proffered by the examiner, with simplistic modifications of the disparate references clearly leads to the non-obviousness of the improved insect swatter, notwithstanding its remarkable simplicity.

The art is quite crowded and many patents have been granted, not for the basic similarities between the those patents, but for the differences therebetween.

To be certain, Applicant's improved insect swatter has fundamental differences over the art of record, including the references applied, and the examiner has failed to establish even prima facie showings for any of the claims being rejected.

Accordingly, reversal of the rejection of claims 5-9 and 18-20 under Section 103(a) over Kopp, Watkins, and Harza is warranted and is requested.

Ground 4

Ground (4) - whether claims 10-16 are unpatentable under 35 USC 103(a) over Kopp, Watkins, Stone, and In re Harza.

Applicant traverses the rejection of claims 10-16 under Section 103(a) over Kopp, Watkins, Stone, and In re Harza.

CLAIM 10

10. A swatter 10 according to claim 7 wherein:

said latch 20 is pivotable between a cocked position wherein said latch 20 extends generally perpendicularly to said rod 12 for retaining said lash second loop 38 thereon, and a fired position wherein said latch 20 is inclined forwardly toward said rod distal end 12b for allowing said lash second loop 38 to slip off said latch 20 for spontaneously contracting said lash 34; and

said trigger 24 is operatively joined to said latch 20 for releasing said latch 20 to pivot from said cocked position thereof to said fired position thereof upon pulling said trigger 24.

Yet again, the fundamental failures of Kopp and Watkins have been addressed above, and these errors are now further compounded by the examiner's introduction of a third, yet additionally disparate reference Stone.

The Federal Circuit recognizes the common examination practice of hindsight selective combination and the mere conclusion of obvious as failing to meet the stringent requirements of Section 103. The Federal Circuit in *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 69 USPQ2d 1686,1690 (Fed. Cir. 2004) provides the following guidelines:

In making the assessment of differences, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. *Envtl. Designs, Ltd. v. Union Oil Cot* 713 F.2d 693, 698 [218 USPQ 8651] (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements."). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a road map to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.

Section 103 precludes this hindsight discounting of the value of new combinations by requiring assessment of the invention as a whole. This court has provided further assurance of an "as a whole" assessment of the invention under § 103 by requiring a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would select the various elements from the prior art and combine them in the claimed manner. In other words, the examiner or court must show some suggestion or motivation, before the invention itself, to make the new

combination. See in re Rouffet, 149 F.3d 1350, 1355-56 [47 USPQ2d 1453] (Fed. Cir. 1998).

The examiner's selective combination of disparate references is well apparent: Kopp for "A", Watkins for "B" and now Stone for "C," and further complicated by the use of Harza for mere duplication of parts.

How can Harza be applied in any fairness now that the examiner is attempting to use three disparate references? Has not the significance of "mere duplication" been lost, since much, much more is being proffered by the examiner under the mere contention of "mere duplication."

Also well apparent is the failure of the examiner to provide the requisite legal motivation to select the various elements from the applied references. That legal motivation must be supported by evidence in the applied references, and "before the invention itself," which prevents the examiner from using Applicant's claims as the road map or guide.

The examiner recites certain features of Stone, but conspicuously overlooks the fundamental teaching of Stone that the rubber band is fired away from the barrel 10. Clearly, this basic teaching teaches away from any combination of the three disparate references.

Also equally clear, is the examiner's insidious use of impermissible hindsight in its most classic form: i.e. selecting from the three references only certain features to the exclusion of other features, and without regard to the problems being solved therein.

No patent application could pass this type of hindsight examination. The examiner did the same thing in the parent application, and now continues in this application. Yet, in the parent application two Boards of Appeal twice reversed the examiner's two different sets of rejections of all the claims to find allowable subject matter.

What the examiner clearly overlooks in his attempt to use the latch 30 of Stone, is the fundamentally different

construction of Kopp and Watkins.

How is it even possible to incorporate the latch 30 of Stone in Kopp? Substitute the recess 8? Why? This would require a wholesale change in the design of Kopp.

How is it even possible to incorporate the latch 30 of Stone in Watkins? Substitute the pin 18? Why? This would require a wholesale change in the design of Watkins.

The examiner merely opines that "one latch is being substituted for another," yet the examiner has not shown how this is even possible given the different configurations of the band 5 of Kopp, and band 14 of Watkins; and the different configurations of the three types of guns.

The examiner's bald contention that "the function is the same" is clearly erroneous. Even a superficial review of the teachings of Kopp and Watkins clearly shows to the contrary, and two patents were nevertheless issued by the USPTO.

In Kopp, the recess seats the knob 6 to fire the band.

In Watkins, the pin 18 holds the loop 16 to fire the projectile 20.

And in Stone, the hammer bevel 30 holds the band 33 to hurl it away from the barrel 10.

Indeed, it is not seen how either Kopp or Watkins could operate with the latch 30 of Stone since the constructions are quite different, and would require wholesale reconstruction in Kopp and Watkins to meet the examiner's proposed combination.

The examiner merely contends that "no stated problem is solved," which is itself erroneous; and the examiner, himself, fails to identify any "stated problem" in either Kopp, or Watkins, or Stone for which the examiner's proffered "solution" would have any relevance to any of the claims, including, fundamentally, independent claim 1 itself.

Stated problem? Applicant's specification is replete with expressly stated problems, none of which has been addressed by the examiner in his rush to reject.

Many paragraphs containing these problems have been

listed above.

The double bands introduced in claim 1 specifically address many stated problems, apparently overlooked by the examiner in his rush to reject.

For claim 10, the examiner for the first time addresses "problems," but not in evaluating Applicant's claims in the whole, and not for affording any weight to Applicant's claims; but, to the contrary, in attempting to apply the disparate teachings of the third reference Stone to the first two references Kopp and Watkins being applied in series, in fabricating a rejection, clearly in hindsight.

The latch 20 as recited in claim 10 is introduced at paras. 30-33, and the construction thereof is disclosed in detail, including its performance and the problems it overcomes.

For example, the latch must be configured to retain the loop, allow it to slide off, and allow spontaneous firing of the double-band lash.

The details recited in claim 10 are fundamentally different than the firing mechanisms in Kopp, Watkins, and Stone that the examiner has no basis to challenge the efficacy of those details in claim 10, when that latch cooperates with the specifically recited lash, which is quite unlike those disclosed in the applied references.

Accordingly, claim 10 patentably distinguishes over the three applied references which are configured and operate quite differently from each other, and from the swatter recited in claim 10.

CLAIM 11

11. A swatter 10 according to claim 10 wherein said latch 20 includes a thumbgrip extending generally perpendicularly therefrom for manually returning said latch 20 to said cocked position thereof.

The examiner's failure to afford any weight to any claim

is further evidenced in his remarks regarding claim 11 which introduces the thumbgrip 28 on the latch 20 as disclosed at para. 39.

Notwithstanding the examiner's own admission that the three references being applied do not "show a thumb grip," the examiner routinely attempts to apply "Judicial Notice that thumb grips are old...."

This expedient by the examiner is not supported by the stringent requirements of the MPEP; nor does it appear to have even a colorable basis.

On page 9 of the 9/20/2001 decision on Appeal No. 2000-2033 in the parent application, the Board of Appeals found substantially the same argument presented by the same examiner for substantially the same features being introduced in claim 11 of that parent application to be untenable, and lacking of evidence.

The examiner's attempt to repeat that previous ground of rejection is equally defective here, and further evidence of the failure of the examiner to evaluate Applicant's claims in the whole, and the failure to afford due weight to the express combinations thereof, which poisons the examiner's rejections of all the claims; as well as the examiner's failure to afford any deference to the previous decision of the BPAI under substantially the same issue.

The examiner merely opines that "it would have been obvious to employ a thumb grip to make cocking easier."

How would this be done in the three references?

Why?

In Kopp, the knob 6 is retained in the recess 8. And the trigger 9 clearly provides triggering as easy as apparently possible. No cocking of the fixed piece 7 is required.

So, how would a thumb grip make any cocking easier in this reference? How would Kopp be modified to include a thumb grip? And, where is the evidence to support the introduction of a thumb grip?

In Watkins, the loop 16 is held on the pin 18, and that pin 18 extends up from handle 12 which has the two operative gaps 24,26.

The trigger hold 28 in Watkins could not be any easier. So, how would a thumb grip make any cocking easier in this reference? How would Watkins be modified to include a thumb grip; which does not appear even possible? And, where is the evidence to support the introduction of a thumb grip?

In Stone, the band 33 is held on the hammer bevel 30, and that hammer adjoins the trigger 22. How would a thumb grip make any cocking easier in this reference? How would Watkins be modified to include a thumb grip, when the bevel 30 already extends aft? And, where is the evidence to support the introduction of a thumb grip?

The examiner has clearly prejudged this application, as well as the parent application, and is using the benefit of hindsight in his role as examiner to deny Applicant's claims a fair evaluation.

If the examiner refuses to recognize the allowable subject matter of the features being introduced in claim 11, which allowability is clearly supported by the previous decision by the Board of Appeals, how then can the examiner's rejections of the other claims be considered fair and devoid of impermissible hindsight?

Not one claim has this examiner indicated as containing allowable subject matter. Not one claim; and without regard to the ten year odyssey in the parent application, which is now fated to be repeated?

CLAIM 12

12. A swatter 10 according to claim 11 further comprising:
a spring 26 joined between said trigger 24 and said handgrip 14;
said trigger 24 being pivotable between a cocked position holding said latch 20 in said cocked position thereof, and a fired position releasing said latch 20 for pivoting said latch 20 to said fired position thereof; and

said spring 26 being positioned for providing a returning force on said trigger 24 to return said trigger 24 to said cocked position thereof upon release of said trigger 24.

Claim 12 recites the spring 26 in a specific combination as disclosed in paras. 36 and 37. Yet, the examiner attempts to use the spring 27 of Stone without any regard to the different configuration thereof, and without regard to the different configurations of Kopp and Watkins: clearly evidence of impermissible hindsight.

Where and how would the spring 27 of Stone be introduced in Kopp, and for what benefit?

Kopp already has the resilient trigger 9, so what benefit is there in Kopp to increase the complexity of that trigger 9 to add another level of spring capability?

Where and how would the spring 27 of Stone be introduced in Watkins, and for what benefit?

In Watkins, the trigger hold 28 requires no spring at all. Instead, the trigger hold 28 is squeezed relative to the handle 12 which deforms at the connection 22 with the body B as disclosed at col. 3, ll. 38+.

Why then add to the complexity of Watkins to add the spring of Stone when there is no benefit for such additional complexity?

Hindsight is the reason the examiner attempts to combine Stone with Kopp and Watkins. Plain and simple hindsight, without regard to the specific configurations of the three disparate references, without regard to any problem solving analysis, without regard to the whole of these references or to the whole of Applicant's claims, and without regard to the stringent requirements of the MPEP and the substantial case law presented therein for evaluation by the examiner.

The differences in configurations of these references is outstanding, yet the examiner in a blind rush to reject clearly must overlook any and all such differences in the rote rejection of claim by claim, as conspicuously evident in

the remarks of record.

Claim 12 clearly recites patentable features well distinguishable over the applied references, and the examiner's rote contention to the contrary fails to establish even a prima facie showing.

CLAIM 13

13. A method of using the swatter 10 of claim 12 comprising:

cocking said thumbgrip to position said latch 20 into said cocked position thereof;

stretching said lash 34 by pulling said lash second loop 38 generally parallel to said rod 12 and adjacent to said rod proximal end 12a, and placing said knot 40 mediate said rod 12;

latching said lash second loop 38 around said latch 20; gripping said handgrip 14 to aim said rod distal end 12b at said insect; and

pulling said trigger 24 to release said latch 20 to said fired position thereof to spontaneously contract said lash 34 for swatting said insect.

The examiner's rejection of method claim 13 lacks any showing of "Kopp as modified by Watkins."

None of these three references discloses or suggests the use of two annular bands, with a knot therebetween which is mediate the rod during the firing process.

"Envisions the method steps" the examiner baldly opines in para. 4?

In Kopp, the knob 6 is released from the recess 8.

In Watkins, the projectile 20 is hurled when the leather loop 16 is released.

And, in Stone the entire band 33 itself is hurled away when fired.

No, these references clearly do not "envision the method steps" of claim 13; but to the contrary, these references teach away from claim 13 in view of their quite different construction, and quite different operation; none of which the examiner recognizes in the rush to reject claim by claim,

notwithstanding the increasing complexity of those claims as disparate features are added in sequence.

Method claim 13 is clearly patentable over the applied references since those references lack corresponding structure and cooperation thereof which could or might be operated in the specific method recited in claim 13.

CLAIM 14

14. A swatter 10 according to claim 12 wherein:
said lash 34 has an unstretched length;
said rod 12 and latch 20 have a collective cocked length measured between said keyhole slot 30 and said latch 20 in said cocked position thereof; and
said cocked length is selected for stretching said lash 34 to about its maximum stretchable length without breaking thereof.

Regarding the examiner's rejection of claim 14, the examiner has pointed to no evidence in any one of the three references to support the specific combination recited therein. "Envision" is clearly not the same as evidence, and Applicant has requested that the examiner cite specific evidence in these references to support the rejection under Section 103, but the examiner has not.

Recall that the examiner first requires Harza for the mere duplication of parts, i.e. the band 5 of Kopp.

If that band 5 were truly duplicated in the "mere" manner of Harza, then that duplicated band 5 would be identical to itself, with knobs 4,6 at opposite ends, and, of course, having the same length.

However, the duplicated bands 5 would have to be combined, but the examiner has not explained how.

If combined "lengthwise" they would be too long for the stock 2. The unstretched length thereof would therefore be about twice the length of the stock 2, which would not meet the recitation of claim 14.

It is noted that Kopp fails to disclose any unstretched

length of the band 5, which could be anything; and anything does not a rejection under Section 103 support.

Accordingly, claim 14 is patentably distinguishable over the applied references, and the examiner has failed to establish even a prima facie showing.

CLAIM 15

15. A swatter 10 according to claim 14 wherein said cocked length is at least three times said lash 34 unstretched length. See paras. 48, 59, & 63-65.

Regarding claim 15, Applicant requested that the examiner provide the source of his "definition of an elastic material [being] one that stretches three times its original length," but the examiner has not.

This definition is clearly rote examiner argument in its most conspicuous form, and fails to recognize not only the common knowledge, of which the examiner may take Judicial Notice, but also Applicant's express disclosure of the different capabilities of differently configured rubber bands.

A short, fat rubber band may not be stretched past its own length, let alone multiple (3x) lengths.

A long, thin rubber band may be stretched more.

And, differently configured rubber bands are found in between.

The three references Kopp, Watkins, and Stone are configured and function differently than Applicant's claim 15, and the configurations of the different bands thereof are necessarily different, and the examiner has not shown otherwise.

The band 2 in Kopp is slender with knobs 4,6 at opposite ends, and Kopp is silent on the requisite length of the band 5.

The band 14 in Watkins is short and fat for propelling a projectile, and Watkins is silent on the requisite length thereof.

And, the band 33 in Stone is configured as a projectile to be propelled away, perhaps never to be seen again, and Stone is silent on the requisite length thereof.

So where is the examiner's proffered definition of elastic material found in Kopp, or Watkins, or Stone, or Harza, or the common dictionary?

The more complex Applicant's claims become in the dependent sequence thereof, the shorter the examiner's rejection becomes. Why?

The insidious use of hindsight is easily and commonly employed in typical USPTO practice, as well evidenced by the repeated rejections of record.

It is one thing for an examiner to merely contend, citing McLaughlin for example, that the examiner has used only knowledge within the ordinary skill of the art instead of Applicant's disclosure, but without supporting that mere contention with evidence it is quite another thing to show that the examiner has not used Applicant's own disclosure in fabricating rejections when the examiner is duty bound to thorough study Applicant's disclosure and claims in evaluating patentability thereof.

Claim 15 is just another example of the failure by the examiner to provide requisite evidence, with claim 15 being clearly patentably distinguishable over the applied references.

CLAIM 16

16. A swatter 10 according to claim 14 wherein said first and second bands 36,38 have equal lengths to position said knot 40 midway between said cocked length thereof.

The examiner's contentions regarding claim 16 that "the

function is the same and no stated problem is solved," is yet additional evidence that the examiner has failed to fully evaluate Applicant's specification.

Applicant's specification indeed presents and solves various problems, as indicated in the above-listed paragraphs including paras. 56 & 61-71; for which the examiner baldly fails to afford any weight thereto, let alone due weight.

The examiner has failed to recognize any one of those problems listed in the specification at paras. 6-10, for example, and solved by Applicant's recited claims; and has failed to challenge the sufficiency or relevancy thereof in his blind rush to reject.

How is it possible that the examiner could have read and evaluated Applicant's specification in the whole, yet still makes unsupported and unqualified statements that "no stated problem is [being] solved?"

The examiner's use of Kopp requires Harza for the "mere duplication" of the single-strand band 5, without explanation of how that single band 5 could be duplicated in the toy gun of Kopp.

Duplication requires two of the same band 5, which would have the same length when placed side by side as the examiner contends, without any knot between the opposite ends when stretched on the stock 2.

Duplication of the bands 5 end to end as the examiner opines in the alternative would result in a combined length twice that of the single band and place the junction thereof in apparently the same location on the fixed piece 7 at the aft end of the stock 2.

So, where is any evidence or explanation that these two different embodiments correspond in any manner to the equal length bands recited in claim 16, in which the knot 40 is positioned midway between the cocked length thereof?

Clearly, the examiner has failed to establish any basis to reject claim 16, let alone a prima facie showing, and therefore claim 16 is patentably distinguishable over the

references being applied.

Accordingly, reversal of the rejection of claims 10-16 under Section 103(a) over Kopp, Watkins, Stone, and Harza is warranted and is requested.

For these exemplary reasons, reversal of all the various rejections is warranted, and allowance of all claims 1-20 is warranted and is requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Francis L. Conte', with a large, stylized circular flourish at the end.

Francis L. Conte

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Attachments:

1. Claims Appendix
2. Evidence Appendix
3. Related Proceedings Appendix

CLAIMS APPENDIX

Claims on appeal:

1. An insect swatter comprising:

an elongate rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect; and

an elastic lash including a pair of annular rubber bands joined together at a knot therebetween, and having a proximal end fixedly joined to said rod distal end, and an opposite distal end sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect.

2. A method of using the swatter of claim 1 comprising:

stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;

aiming said rod distal end at said insect; and

releasing said lash distal end to spontaneously contract said lash for swatting said lash distal end against said insect.

3. A swatter according to claim 1 further comprising:

a latch pivotally joined adjacent to said rod proximal end for releasably latching said lash distal end; and

means for selectively releasing said latch to release said lash distal end for swatting said insect therewith.

4. A method of using the swatter of claim 3 comprising:

stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;

latching said lash distal end to said latch;

aiming said rod distal end at said insect; and

releasing said latch for spontaneously contracting said lash for swatting said insect with said distal end thereof.

5. A swatter according to claim 3 further comprising:
a gun handgrip fixedly joined to said rod proximal end;
said latch being pivotally joined to said handgrip; and
wherein said latch releasing means includes a trigger operatively joined to said latch for releasing said latch upon pulling said trigger.

6. A method of using the swatter of claim 5 comprising:
stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;
latching said lash distal end to said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

7. A swatter according to claim 5 wherein:
said rod distal end includes a keyhole slot; and
a first one of said rubber bands includes said lash proximal end forming a first loop disposed through said keyhole slot for fixedly joining said lash to said rod, and a second one of said rubber bands includes said lash distal end forming a second loop positionable around said latch for being retained thereby.

8. A method of using the swatter of claim 7 comprising:
stretching said lash by pulling said lash second loop generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;
latching said lash second loop around said latch;
gripping said handgrip to aim said rod distal end at said insect; and

pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

9. A swatter according to claim 7 wherein:

said latch extends upwardly from said handgrip;

said keyhole slot is open downwardly in a direction opposite to said upward extension of said latch; and

said lash is inclined upwardly from said keyhole slot to said latch when latched thereto, and said knot is positioned atop said rod.

10. A swatter according to claim 7 wherein:

said latch is pivotable between a cocked position wherein said latch extends generally perpendicularly to said rod for retaining said lash second loop thereon, and a fired position wherein said latch is inclined forwardly toward said rod distal end for allowing said lash second loop to slip off said latch for spontaneously contracting said lash; and

said trigger is operatively joined to said latch for releasing said latch to pivot from said cocked position thereof to said fired position thereof upon pulling said trigger.

11. A swatter according to claim 10 wherein said latch includes a thumbgrip extending generally perpendicularly therefrom for manually returning said latch to said cocked position thereof.

12. A swatter according to claim 11 further comprising:

a spring joined between said trigger and said handgrip;

said trigger being pivotable between a cocked position holding said latch in said cocked position thereof, and a fired position releasing said latch for pivoting said latch to said fired position thereof; and

said spring being positioned for providing a returning force on said trigger to return said trigger to said cocked

position thereof upon release of said trigger.

13. A method of using the swatter of claim 12 comprising:

cocking said thumbgrip to position said latch into said cocked position thereof;

stretching said lash by pulling said lash second loop generally parallel to said rod and adjacent to said rod proximal end, and placing said knot mediate said rod;

latching said lash second loop around said latch;

gripping said handgrip to aim said rod distal end at said insect; and

pulling said trigger to release said latch to said fired position thereof to spontaneously contract said lash for swatting said insect.

14. A swatter according to claim 12 wherein:

said lash has an unstretched length;

said rod and latch have a collective cocked length measured between said keyhole slot and said latch in said cocked position thereof; and

said cocked length is selected for stretching said lash to about its maximum stretchable length without breaking thereof.

15. A swatter according to claim 14 wherein said cocked length is at least three times said lash unstretched length.

16. A swatter according to claim 14 wherein said first and second bands have equal lengths to position said knot midway between said cocked length thereof.

17. An insect swatter comprising:

an elongate rod having a slot at a distal end thereof;

an elastic lash configured in a figure eight with first and second knot-less loops at opposite ends, and joined together at a knot therebetween; and

said lash first loop is retained in said slot.

18. A swatter according to claim 17 further comprising:

a handgrip fixedly joined to a proximal end of said rod opposite from said distal end thereof;

a latch pivotally joined to said handgrip adjacent to said rod proximal end for releasably latching said lash second loop; and

a trigger operatively joined to said latch for releasing said latch upon pulling said trigger.

19. A swatter according to claim 18 wherein said lash includes a pair of annular rubber bands joined together in series at said knot, and having a collective spring rate equal to the reciprocal of the sum of the reciprocals of the spring rates of each of said bands.

20. A swatter according to claim 19 wherein said pair of rubber bands are identical in size, cross section, and material composition, and have equal lengths to position said knot midway between said first and second loops.

EVIDENCE APPENDIX

Statement: Attached are enlarged figures 1 and 2 of the Kopp reference (U.S. Patent 1,009,531). This evidence was entered by the examiner in the first Office Action dated 07/28/2004.

Fig. 2.

USP 1009531.

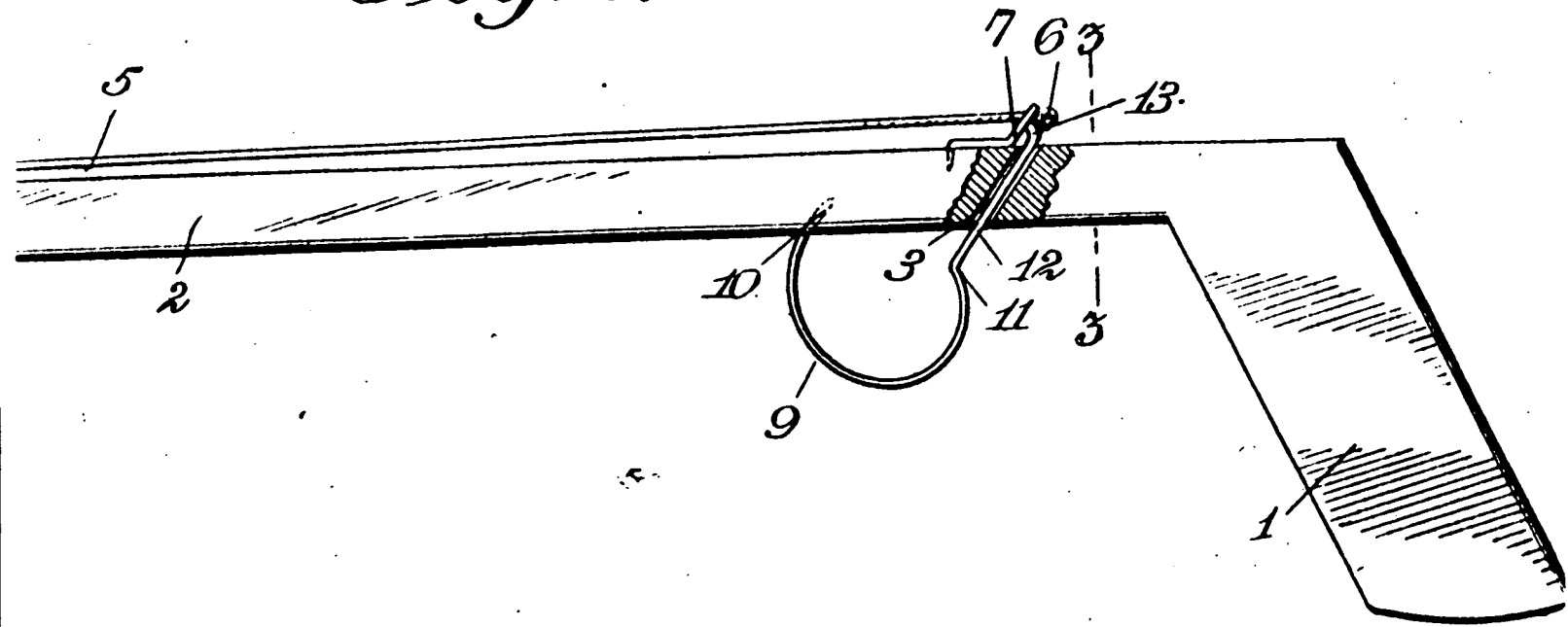
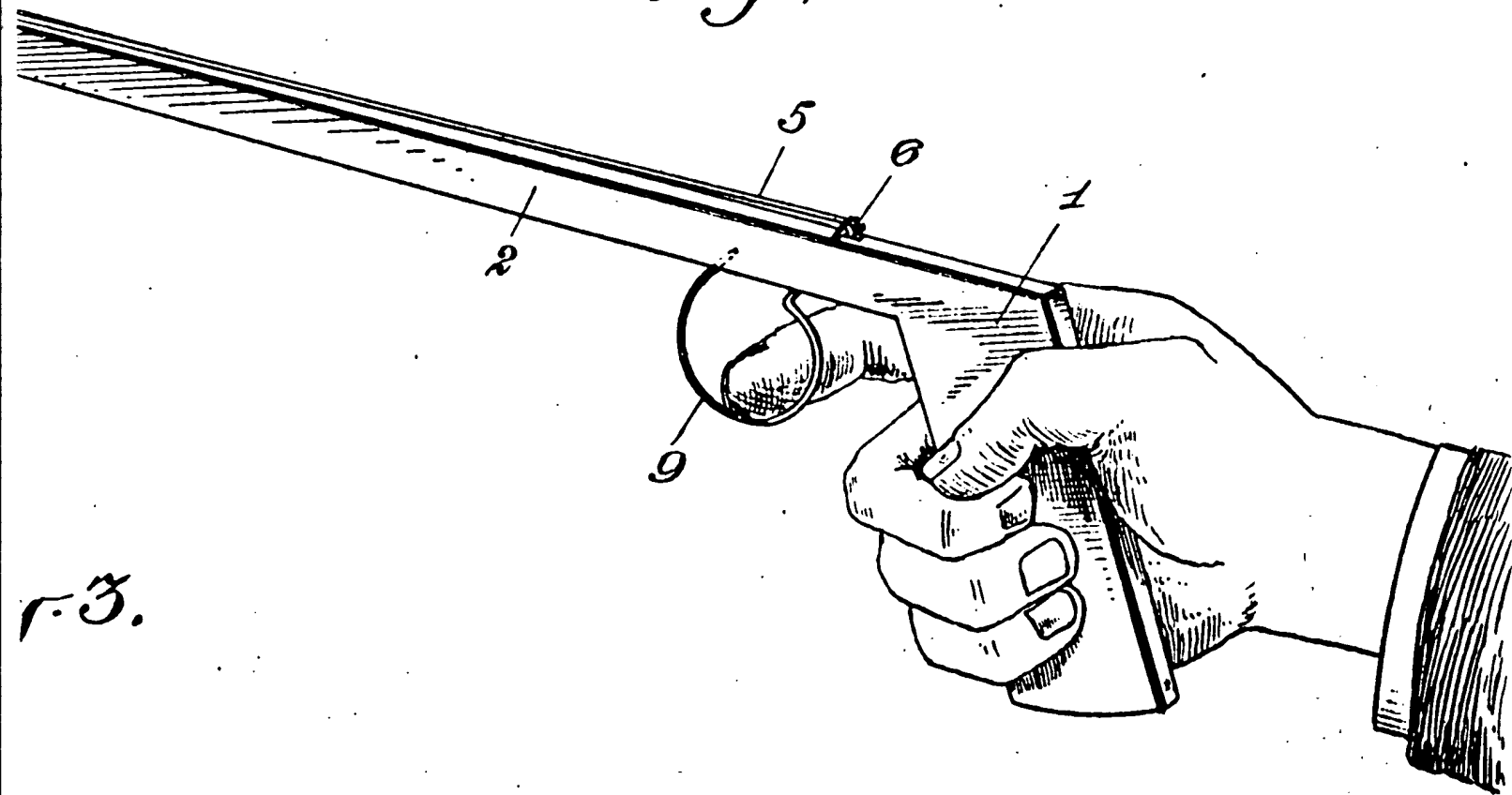


Fig. 1.



r. 3.

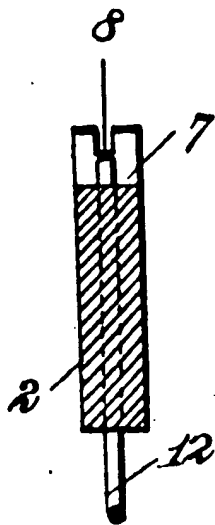
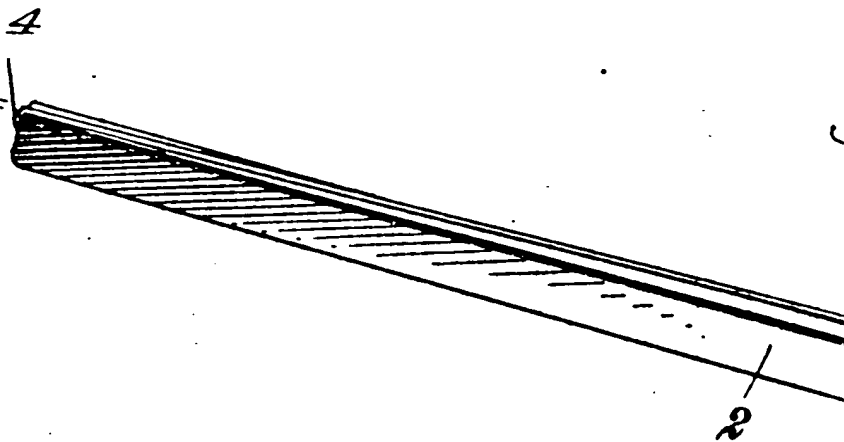
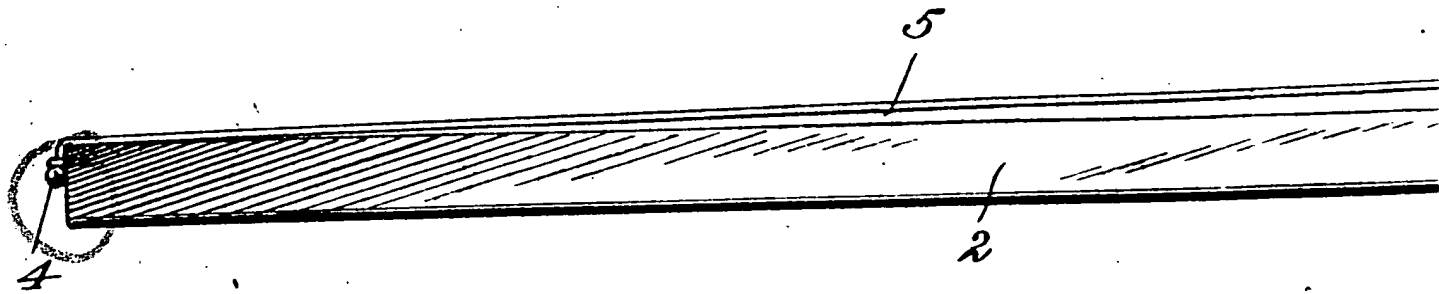


Fig. 3.

WITNESSES:

INVENTOR
Frank A. Hooper

RELATED PROCEEDINGS APPENDIX

Attached are copies of related decisions rendered by the court or by the Board.

1. Decision by BPAI on Appeal No. 96-3971, dated 22 Sep 1998
2. Decision by BPAI on Appeal No. 2000-2033, dated 20 Sep 2001
3. Judgment by CAFC on Fed. Cir. Appeal No. 02-1150, dated 5 Jun 2002

NOTE: Pursuant to Fed. Cir. R. 47.6, this disposition is not citable as precedent. It is a public record. The disposition will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

02-1150
(Serial No. 08/331,851)

IN RE FRANCIS L. CONTE

DECIDED: June 5, 2002

Before MAYER, Chief Judge, LOURIE and LINN, Circuit Judges.

LOURIE, Circuit Judge.

DECISION

Francis L. Conte appeals from the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences affirming the rejection of claims 1 and 4-10 of U.S. Patent Application Serial No. 08/331,851 as obvious under 35 U.S.C. § 103. Ex parte Conte, Appeal No. 2000-2033, slip op. at 9 (Bd. Pat. App. & Inter. Sept. 20, 2001) (Paper No. 27) ("Conte II"). Because the Board's decision was supported by substantial evidence and is correct as a matter of law, we affirm.

DISCUSSION

Mr. Conte is the named inventor of the '851 application, which relates to an insect swatter. In one embodiment of the invention, an elastic band is stretched between the proximal and distal ends of a gun. The band contracts and swats an insect when released by a trigger mechanism. The claims on appeal read as follows:

1. An insect swatter comprising:
 - an elongate rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect;
 - an elastic lash in the form of an annular rubber band having a proximal end forming a first loop fixedly joined to said rod distal end, and also having an opposite distal end forming a second loop, said lash being sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect;
 - a latch pivotally joined adjacent to said rod proximal end for releasably latching said lash distal end so that said second loop is positioned around said latch for being retained thereby; and
 - means pivotally joined adjacent to said latch for selectively releasing said latch to release said lash' distal end for swatting said insect therewith.

...
4. A method of using the swatter of claim 1 comprising:
 - stretching said lash by pulling said distal end thereof generally parallel to said rod and adjacent to said rod proximal end;
 - latching said lash distal end to said latch;
 - aiming said rod distal end at said insect; and
 - releasing said latch for spontaneously contracting said lash for swatting said insect with said distal end thereof.
5. A swatter according to claim 1 further comprising:
 - a gun handgrip fixedly joined to said rod proximal end;
 - said latch being pivotally joined to said handgrip; and
 - wherein said latch releasing means includes a trigger operatively joined to said latch for releasing said latch upon pulling said trigger.
6. A method of using the swatter of claim 5 comprising:
 - stretching said lash by pulling said distal end thereof generally parallel to said rod adjacent to said rod proximal end; latching said lash distal end to said latch;
 - gripping said handgrip to aim said rod distal end at said insect; and
 - pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.
7. A swatter according to claim 5 wherein:
 - said rod distal end includes a keyhole slot;
 - and said lash first loop is disposed through said keyhole for fixedly joining said lash to said rod.
8. A method of using the swatter of claim 7 comprising:

stretching said lash by pulling said lash second loop generally parallel to said rod and adjacent to said rod proximal end;
latching said lash second loop around said latch;
gripping said handgrip to aim said rod distal end at said insect; and
pulling said trigger to release said latch to spontaneously contract said lash for swatting said insect.

9. A swatter according to claim 7 wherein:

said latch extends upwardly from said handgrip; said keyhole slot is open downwardly in a direction opposite to said upward extension of said latch; and said lash is inclined upwardly from said keyhole slot to said latch when latched thereto.

10. A swatter according to claim 7 wherein:

said latch is pivotable between a cocked position wherein said latch extends generally perpendicularly to said rod for retaining said lash second loop thereon, and a fired position wherein said latch is inclined forwardly toward said rod distal end for allowing said lash second loop to slip off said latch for spontaneously contracting said lash; and

said trigger is operatively joined to said latch for releasing said latch to pivot from said cocked position thereof to said fired position thereof upon pulling said trigger.

Mr. Conte filed the '851 application on October 31, 1994. The examiner initially rejected the claims under 35 U.S.C. § 103 as being unpatentable over a combination of two references, a rejection that was later reversed by the Board. Ex parte Conte, Appeal No. 96-3971, slip op. at 4 (Bd. Pat. App. & Inter. Sept. 22, 1998) (Paper No. 11) ("Conte I"). Thereafter, the examiner rejected the claims under §§ 102 and 103 over new references, Caron and Kopp, and Watkins, which had previously been cited. In response, Conte petitioned the Director of the Patent and Trademark Office ("PTO") for mandamus to direct the examiner to allow the claims, arguing that the examiner should not have reopened prosecution of the claims under 37 C.F.R. § 1.181. The Director denied that petition. Conte then challenged the rejection on the merits at the Board, which affirmed the examiner's rejection as to the claims now on appeal, claims 1 and 4-10, but reversed as to claims 11-15. The Board determined that the rejection was not

precluded as res judicata by the Board's previous decision in Conte I. Conte II at 5. On the merits, the Board determined that the asserted references were analogous art and agreed with the examiner that it would have been obvious to combine the toy gun disclosed in Kopp for striking insects with a rubber band with the latch-releasing means taught by Caron. Id. at 6. The Board also affirmed the rejection of claims 7-10 over Kopp, Caron, and Watkins in view of the disclosure in Watkins of a keyhole slot allowing for ready replacement of the rubber band. Id. at 8. Conte timely appeals from the Board's decision; we have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4)(A).

We review the Board's legal conclusion of obviousness de novo and the factual underpinnings of its decision for substantial evidence. In re Gartside, 203 F.3d 1305, 1315, 53 USPQ2d 1769, 1774 (Fed. Cir. 2000). Whether a reference is analogous art is a question of fact and is therefore reviewed for substantial evidence. In re Clay, 966 F.2d 656, 658-59, 23 USPQ2d 1058, 1060 (Fed. Cir. 1992). Under the substantial evidence standard, we will affirm the Board's factual determinations if they are based upon "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Gartside, 203 F.3d at 1312, 53 USPQ2d at 1773 (quoting Consol. Edison v. NLRB, 305 U.S. 197, 229-30 (1938)).

On appeal, Conte argues that the PTO violated 37 C.F.R. § 1.198 when it permitted the examiner to reopen prosecution despite having reversed the examiner's original rejections in Conte I. He also argues that the PTO erred in rejecting the claims over references previously of record, citing this court's decision in In re Portola Packaging, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). He further contends that the asserted references are non-analogous art because (1) Kopp teaches "striking"

insects, not killing them; (2) Caron relates only to toy guns, not to those that kill insects; and (3) Watkins similarly discloses no utility as an insect swatter, and its use as such would likely cause the insect to be squashed and leave an undesirable stain. On the merits, Conte asserts that the Board mischaracterized Kopp as having an annular band and a first and second loop as in claim 1. He also argues that the Board erred in concluding that it would have been obvious to combine Kopp and Caron because Caron discloses catapulting the elastic band away, whereas Kopp teaches that the band remains attached to the stock, and that a combination of those references would render them inoperable. Conte also disagrees with the Board's determination that the exact orientation of the keyhole slot of Watkins is a design choice. Finally, Conte argues that the Board did not consider objective evidence of the superiority of his invention over the prior art.

We agree with the PTO that we lack jurisdiction to consider Conte's appeal from the Director's decision denying Conte's petition concerning the examiner's action in reopening prosecution following Conte I. Our jurisdiction in appeals from the PTO is limited to appeals from the Board of Patent Appeals and Interferences under 28 U.S.C. § 1295(a)(4)(A) and decisions of the Director of the PTO or the Trademark Trial and Appeal Board with respect to trademark applications under 28 U.S.C. § 1295(a)(4)(B). As neither of those sections confers jurisdiction over Conte's appeal from the Director's decision concerning the Rule 181 petition, we must decline to consider Conte's appeal on that issue. See In re Makari, 708 F.2d 709, 711, 218 USPQ 193, 194 (Fed. Cir. 1983) ("We do not have jurisdiction to review decisions of the Commissioner on petitions.").

We also agree with the PTO that the Board did not err in concluding that the examiner, upon reopening prosecution, could consider the references of record. Conte's reliance on Portola Packaging is misplaced. That case concerned reexamination, which statutorily requires in the first instance a determination that the asserted references "raise[] a substantial new question of patentability affecting any claim of the patent concerned." 35 U.S.C. § 303(a) (1994). The field of references available to the examiner is not so constrained, however, for examination of claims following a Board reversal of an earlier rejection. Rather, "in rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command." 37 C.F.R. § 1.104(c)(2); see also Portola Packaging, 110 F.3d at 790, 42 USPQ2d at 1299 (distinguishing between original prosecution and reexamination in determining that, in reexamination, the examiner may apply only references not previously cited against the claims). We therefore conclude that the Board did not err in affirming the examiner's post-Conte I rejections over references that had previously been of record.

Turning to the Board's decision on the merits, we conclude that substantial evidence supports the Board's factual findings and that its legal conclusion of obviousness is not contrary to law. We disagree with Conte's arguments that the asserted references are nonanalogous art. A prior art reference is analogous if it is from the same "field of endeavor," even if it addresses a different problem, or, if not within the same field, if the reference is "reasonably pertinent to the particular problem with which the inventor is involved." See In re Clay, 966 F.2d at 658-59, 23 USPQ2d at 1060. Kopp, Caron, and Watkins would have been viewed by a skilled artisan as being

in the same field of endeavor as the claimed invention or at least reasonably pertinent to the problem of killing insects by swatting them with rubber bands. Kopp's teaching of "striking" an insect with an elastic band is clearly in the same field of endeavor as the claimed invention of "killing" an insect. U.S. Patent 1,009,531, col. 2, ll. 73-4. Similarly, Caron's release mechanism for a device for striking any object with a rubber band is pertinent to addressing the problem of an appropriate release mechanism for a device that strikes insects with a rubber band. U.S. Patent 2,054,719, col. 2, ll. 15-27. Watkins is also analogous art because it addresses the problem addressed in claims 7-10, viz., attaching a rubber band to a mechanical gun and discharging that rubber band in the direction of an object. U.S. Patent 2,642,057, col. 4, l. 64 to l. 20, col. 5, l. 2. We disagree with Conte's argument that Watkins is not pertinent because the insect would be squashed and result in staining if the projectile shot from the gun of Watkins were accurately directed to hit an insect. Watkins describes an embodiment that shoots rubber bands rather than small projectiles, id., and the effect of the snapping action on an insect by those rubber bands would necessarily be similar to that in the pending claims. Moreover, while squashing and staining may be undesirable, they hardly make the reference not pertinent. We therefore conclude that substantial evidence supports the Board's decision that the cited references are analogous.

We also affirm the Board's conclusion that the subject matter of claims 1 and 4-10 would have been obvious in view of those references. Kopp teaches a toy gun for striking insects. '531 patent, col. 1, ll. 14-15. It discloses a resilient band that is fastened to the end of the gun stock. Id. at col. 1, ll. 34-45. The other end of the band is provided with a knob or knot and fastened to a releasing means at the other end of

the stock. Id. Although Kopp does not explicitly teach an "annular" band as Conte has claimed, the term "band" itself connotes a ring-like structure that would inherently possess first and second loops as in the claimed invention, and Figure 1 of Kopp appears to show a band in the form of a ring. In any event, Caron also teaches an annular band having such loops. '719 patent, Figure 1. We therefore conclude that substantial evidence supports the Board's conclusion that the asserted references disclose the annular band and first and second loop limitations of claim 1.

We also conclude that the Board did not err in its determination that the subject matter of claims 1 and 4-6 would have been obvious over Kopp in view of Caron. Caron teaches the limitation in those claims of a lash that is released by a pivoting latch member adjacent to the proximal end of the rod and that engages the elastic band. '719 patent, col. 1, l. 35 - col. 2, l. 14. In Caron, the latch is released by a trigger that discharges the rubber band from the toy gun. Id. at col. 1, ll. 5-6. Conte argues that Caron teaches away from the claimed invention because the elastic band is launched from the gun rather than retained at the distal end. We disagree. The discharge mechanism enabling a positive acting release of the band is irrelevant to whether the band released by that mechanism is ultimately retained or discharged at the end of the gun. We therefore conclude that the Board did not err in determining that one of ordinary skill in the art would have combined the release mechanism of Caron with the toy gun of Kopp.

We also affirm the Board's conclusion that the subject matter of claims 7-10 would have been obvious in view of the teaching of Watkins of a keyhole slot used to attach the rubber band to the front of the gun barrel. '057 patent, col. 3, ll. 13-17.

Although Watkins teaches a slot that opens upwardly rather than downwardly, as recited in Conte's claims 9 and 10, we agree with the Board that such a difference would have been a fairly insignificant design choice, as both types of slots would retain the rubber band. See In re Rice, 341 F.2d 309, 314, 144 USPQ 476, 480 (CCPA 1965) (concluding that minor differences between the prior art and a claimed device may be a matter of design choice absent evidence to the contrary).

Finally, regarding Conte's arguments that the claims are patentable in light of secondary considerations of nonobviousness, we agree with the PTO that Conte has not demonstrated by objective evidence that his invention has superior "whipping" action over the prior art. In fact, the prior art appears to teach the same action. See, e.g., '531 patent (Kopp), col. 2, ll. 59-74 (describing the action of releasing the band so that it strikes an insect while contracting to its original, unstretched position).

We have considered Conte's remaining arguments and find them to be unpersuasive. Accordingly, we affirm the Board's conclusion affirming the rejection of claims 1 and 4-10 as obvious under § 103.

9/28/98

Paper No. 11

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS L. CONTE

Appeal No. 96-3971
Application 08/331,851¹

ON BRIEF

Before MCCANDLISH, Senior Administrative Patent Judge, and
MEISTER and PATE, Administrative Patent Judges.

PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1 and 4-15. The invention is directed to an insect swatter and method of using such a swatter. The swatter uses a rubber band as an elastic lash to strike an insect.

Claim 1, reproduced below, is further illustrative of the claimed subject matter.

¹ Application for patent filed October 31, 1994.

MAILED

SEP. 22 1998

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

1. An insect swatter comprising:

an elongated rod having a proximal end for being hand-held, and an opposite distal end for being aimed at an insect;

an elastic lash in the form of an annular rubber band having a proximal end forming a first loop fixedly joined to said rod distal end, and also having an opposite distal end forming a second loop, said lash being sized for being elastically stretched from said rod distal end to adjacent said rod proximal end so that release of said lash distal end spontaneously contracts said lash for swatting said lash distal end against said insect;

a latch pivotally joined adjacent to said rod proximal end for releasably latching said lash distal end so that said second loop is positioned around said latch for being retained thereby; and

means pivotally joined adjacent to said latch for selectively releasing said latch to release said lash distal end for swatting said insect therewith.

The references relied on by the examiner are:

Watkins	2,642,057	June 16, 1953
Zaremba	4,774,786	Oct. 4, 1988

The examiner has rejected claims 1 and 4-15 under 35 U.S.C. § 103 as unpatentable over Zaremba in view of Watkins. According to the examiner, the patent to Zaremba shows an insect swatter with all the elements recited in claim 1 with the exception of the rubber band with first and second loops. The examiner is further of the opinion that Watkins shows such a rubber band. Therefore, it is the examiner's conclusion that it would have been obvious to provide Zaremba with a looped rubber band as shown by Watkins since "the function is the same and no unexpected results were made."

OPINION

We have carefully reviewed the rejection on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the determination that the applied prior art does not provide the evidentiary basis for a *prima facie* case of obviousness. Accordingly, we reverse the rejection on appeal.

We note that claim 1, and consequently all claims on appeal, includes the limitation of a latch pivotally joined to said rod proximal end for releasably latching said lash and also includes a means pivotally joined adjacent to said latch for releasing said latch. A close review of the applied prior art of Zaremba and Watkins clearly reveals that neither patent provides evidence of a latch and a means pivotally joined adjacent to said latch selectively releasing said latch. Therefore, we are in agreement with the appellant's arguments on page 12 of the brief that the examiner has failed to address the additional recited elements of claim 1 including the latch 20 and the separate releasing means 24 and 26.


We are in agreement with the appellant that the claim requires two pivoted components--latch 20 and means 24 and 26. The examiner points to the latch and the releasing means of Zaremba which are disclosed clearly as being a single element. Since the claim requires two separate elements and Zaremba discloses only one,

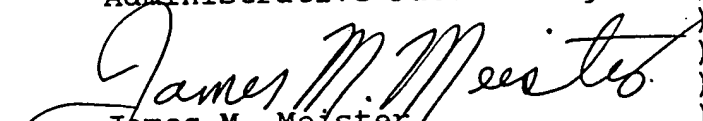
Appeal No. 96-3971
Application 08/331,851


the combined teachings of Zaremba and Watkins fail to establish a
prima facie case of obviousness.

The rejection of claims 1 and 4-15 is reversed.

REVERSED


Harrison E. McCandlish, Senior)
Administrative Patent Judge)


James M. Meister)
Administrative Patent Judge)


William F. Pate, III)
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
INTERFERENCES

9/23/01

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 27

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCIS L. CONTE

Appeal No. 2000-2033
Application 08/331,851

ON BRIEF

MAILED

SEP 20 2001

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Before PATE, STAAB, and McQUADE, Administrative Patent Judges.
PATE, Administrative Patent Judge.

DECISION ON APPEAL

This is the second appeal of the final rejection of claims 1 and 4 through 15. Claims 2 and 3 have been canceled. These are all the claims in the application.

In a first *ex parte* appeal, this board rendered a decision on September 22, 1998 reversing all rejections of claims 1 and 4 through 15. Subsequent to the appeal the examiner reopened

prosecution under 37 CFR § 1.198 and rejected all claims on art previously of record. The applicant petitioned under 37 CFR § 1.181 contending, *inter alia*, that the reopened prosecution failed to comply with 37 CFR § 1.198. In a petition decision rendered on May 21, 1999, applicant's petition was denied. Thereafter, the examiner issued a third office action rejecting all claims. On June 3, 1999, the applicant again filed a petition challenging the propriety of the reopened prosecution. Applicant subsequently filed a Notice of Appeal, and the petition was denied. Thereafter, applicant filed a brief and the examiner submitted an examiner's answer, and the case comes to us as a normal *ex parte* appeal.

The claimed subject matter is directed to an insect swatter which uses an elastic lash in the form of annular rubber band for swatting an insect. The swatter is in the shape of a pistol and the band is stretched along the barrel. A release means is actuated by a latch means to release the stretched rubber band toward the insect.

The references of record relied upon by the examiner as evidence of obviousness are:

Kopp	1,009,531	Nov. 21, 1911
Caron	2,054,719	Sep. 15, 1936
Watkins	2,642,057	June 16, 1953

THE REJECTIONS

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp.

Claims 1 and 4 through 6 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron.¹

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Caron in view of Kopp and further in view of Watkins.

Claims 7 through 15 stand rejected under 35 U.S.C. § 103 as unpatentable over Kopp in view of Caron and further in view of Watkins.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that the applied prior art establishes a *prima facie* case of obviousness with respect to claims 1, 4 through 6 and 7 through 10 on appeal.

¹ Unlike the examiner, we do not consider the order in which prior art is applied in a rejection to be significant. See, for example, In re Bush 296 F.2d 491, 496, 131 USPQ 263, 267 (CCPA 1961) ("[i]n a case of this type where a rejection is predicated on two references each containing pertinent disclosure which has been pointed out to the applicant, we deem it to be a matter of no significance, but merely a matter of exposition, that the rejection is stated to be on A in view of B instead of B in view of A, or to term one reference primary and the other secondary."); In re Cook, 372 F.2d 563, 152 USPQ 615 (CCPA 1967).

This *prima facie* case of obviousness has not been rebutted by additional evidence from the appellant. Accordingly, the rejections of claims 1, 4 through 6 and 7 through 10 are affirmed. The applied art does not establish the *prima facie* obviousness of claims 11 through 15. The rejection of these claims is reversed. Our reasons follow.

Appellant's first argument is that the new rejection of claims 1 and 4 through 15 is unwarranted under the doctrine of *res judicata*, or law of the case, in view of the full reversal of the same claims on evidence in the record by the prior decision of the Board. However, the predecessor to our reviewing court has previously dealt with this issue. The court stated in In re Borkowski, 505 F.2d 713, 718, 184 USPQ 29, 32-33 (CCPA 1974):

Appellants' contention that the prior board decision reversing a rejection under 35 U.S.C. § 103 over *Borkowski et al.* in a parent application should have been "*res judicata*" to the examiner in this case is unpersuasive. This court stated in In re Craig, 411 F.2d 1333, 56 C.C.P.A. 1438 (1969), that the policy and purpose of the patent laws preclude the applicability of any doctrine akin to the judicially-developed doctrine of "*res judicata*" to bar the granting of patents on inventions that comply with the statute. The same policy and purpose precludes reliance on any such doctrine to force the granting of patents on inventions that do not comply with the statute. The Patent Office must have the flexibility to reconsider and correct prior decisions that it may find to have been in error.

Next, appellant raises the issue of a rejection based on cited prior art that was never applied in a reexamination as was the case in In re Portola Packaging, Inc., 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997). However, it is clear, that the result in Portola was dictated by the narrow scope of reexamination afforded the PTO by the statute. In the case of an application for patent, the PTO has broad scope. The court explicitly recognized in Portola the PTO's goal of performing a thorough and conscientious examination before allowing applications to be patented. 110 F.3d at 791, 42 USPQ2d at 1300.

Turning to the rejections based on prior art, it is our finding, that Kopp discloses a toy gun in the form of an elastic lash made of an annular rubber band having a first loop joined to the distal end of an elongated rod. When the lash is released, it spontaneously contracts and may be used to strike "some object such as a fly or an insect [sic]." Kopp releases the elastic lash by way of a trigger made of a single piece of resilient material 9. Thus, Kopp differs from the claimed subject matter in having a resilient trigger 9 which does not include a latch or a means pivotally joined adjacent to the latch for releasing the lash.

It is our finding that Caron also discloses a toy gun having an elongated rod wherein an elastic member formed of an annular rubber band is placed on the end of the rod. Caron teaches releasing the lash by means of a pivoting latch member 8 which is adjacent the proximal end of the rod and which engages the second loop of the elastic band. The pivotal latch is released by a trigger which is pivotally joined to the rod and placed adjacent to the latch for selectively releasing the latch and allowing the annular rubber band to spontaneously contract and be launched off the end of the toy gun. Caron differs from the subject matter claimed in that Caron does not disclose the utility of using the elastic lash for impacting an insect. Furthermore, Caron does not disclose the elastic lash fixedly joined to the distal end of the rod. Inasmuch as Caron discloses a latch and a means comprising a trigger for selectively releasing the latch for the benefit of providing discharge parts of a toy gun with positive control and shock absorption, it would have been obvious to use the pivotal latch and the latch releasing mean of Caron on the toy gun as disclosed in Kopp.

Appellant argues that Caron and Kopp are non-analogous art. We disagree. Turning first to Kopp, the reference teaching is within appellant's field of endeavor, i.e., killing insects with

an elastic lash attached to a toy pistol handle. Furthermore, since Caron is directed to a disclosure which is concerned with releasing an elastic band, Caron is clearly reasonably pertinent to appellant's problem.

Appellant argues that there is no suggestion for the examiner's proposed combination of references. This is clearly not the case. Caron specifically discloses that his release means and his latch are provided to enable a positive acting release of the elastic band. Furthermore, Caron teaches that the provision of spring 16 on his latch means provides a shock absorbing mechanism to preclude the possibility of damage to the pistol. These are express, written suggestions of the desirability of the mechanism of Caron which would have clearly motivate one of ordinary skill to include such modifications on the pistol of Kopp.

We are further in agreement with the examiner that claims 1 and 4 through 10 do not preclude the presence of a knot on the pistol of Kopp. We further disagree with the appellant's repeated assertion that the "primary function of Kopp's toy gun is a toy gun." It seems clear that the disclosure in Kopp mentions killing insects in several locations, and Fig. 1 of the patent clearly discloses using the gun to kill an insect.

Likewise, we affirm the rejection of claims 7 through 10 based on the combined teachings of Kopp, Caron and Watkins. Watkins is cited to disclose a preferred manner of securing the rubber band to the distal portion of the elongated rod of the pistol shaped frame. Watkins uses a keyhole slot which allows ready replacement of the rubber band, but insures that the rubber band will not become easily detached under even the most violent manipulation of the gun. Following this express disclosure of Watkins, it would have been obvious to use a keyhole slot to attach the rubber band to the insect killing gun of Kopp.

Appellant argues that Watkins is not within appellant's field of endeavor. Even if this were the case, appellant has not argued that Watkins is not reasonably pertinent to the problem with which appellant is concerned. In our view, the gun of Watkins is reasonably pertinent to appellant's problem. Appellant states there is no motivation for using the feature of Watkins with the combined teachings of Caron and Kopp. As noted above, Watkins provides express, written motivation or suggestion for the examiner's proposed combination for claims 8 and 9. We agree with the examiner that the exact orientation of the keyhole slot is a design choice. We note appellant's reliance on benefits such as loose support of the lash, easy replacement

thereof, self retention upon firing, etc. The first three of these benefits are expressly disclosed in Watkins' disclosure.

With respect to claims 11 through 15, we are in agreement with the appellant that the applied prior art of Kopp, Caron and Watkins does not render obvious the provision of a thumb grip on the latch as claimed in claim 11. We are cognizant of the examiner's argument that such a thumb grip is prevalent in the art, but we are not convinced of the propriety of maintaining the rejection due to the lack of an evidentiary basis thereof. For this reason it is our conclusion of law that claims 11 through 15 would not have been obvious for the lack of any disclosure in the references of a thumb grip.


SUMMARY

Rejections of claims 1 and 4 through 10 are affirmed. The rejection of claims 11 through 15 is reversed.


Appeal No. 2000-2033
Application 08/331,851

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART


WILLIAM F. PATE, III
Administrative Patent Judge

Lawrence J. Staab
LAWRENCE J. STAAB
Administrative Patent Judge


JOHN P. McQUADE
Administrative Patent Judge

BOARD OF PATENT

APPEALS AND

INTERFERENCES

8/5/02

United States Court of Appeals for the Federal Circuit

02-1150

IN RE FRANCIS L. CONTE

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

in Case NO(S). 08/331,851

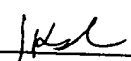
This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED JUN 5 2002

Jan Horbaly 
Jan Horbaly, Clerk

ISSUED AS A MANDATE: JULY 29, 2002

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

NOTICE OF ENTRY OF JUDGMENT ACCOMPANIED BY OPINION

OPINION FILED AND JUDGMENT ENTERED: 06/05/02

The attached opinion announcing the judgment of the court in your case was filed and judgment was entered on the date indicated above. The mandate will be issued in due course.

Information is also provided about petitions for rehearing and suggestions for rehearing in banc. The questions and answers are those frequently asked and answered by the Clerk's Office.

No costs were taxed in this appeal.

Regarding exhibits and visual aids: Your attention is directed to FRAP 34(g) which states that the clerk may destroy or dispose of the exhibits if counsel does not reclaim them within a reasonable time after the clerk gives notice to remove them. (The clerk deems a reasonable time to be 15 days from the date the final mandate is issued.)

JAN HORBALY
Clerk

cc: FRANCIS L. CONTE
JOHN M. WHEALAN

IN RE CONTE, O2-1150
PTO - 08/331,851

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